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1 IN THE UNITED STATES DISTRICT COURT  
2 FOR THE EASTERN DISTRICT OF TEXAS  
3 MARSHALL DIVISION  
4 VOCALIFE LLC, ) (  
5 PLAINTIFF, ) ( CIVIL ACTION NO.  
6 ) ( 2:19-CV-123-JRG  
7 VS. ) ( MARSHALL, TEXAS  
8 ) (  
9 AMAZON.COM, INC. and ) (  
10 AMAZON.COM LLC, ) ( OCTOBER 8, 2020  
11 DEFENDANTS. ) ( 12:12 P.M.  
12 TRANSCRIPT OF JURY TRIAL AND BENCH TRIAL  
13 AFTERNOON SESSION  
14 BEFORE THE HONORABLE JUDGE RODNEY GILSTRAP  
15 UNITED STATES CHIEF DISTRICT JUDGE  
16  
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23

24 (Proceedings recorded by mechanical stenography, transcript  
produced on a CAT system.)

25

## P R O C E E D I N G S

(Jury out.)

(Jury trial.)

COURT SECURITY OFFICER: All rise.

THE COURT: Be seated, please.

Counsel, we have received a note from the jury.

I'll read it to you, and it reads as follows:

Can we see the code evidence, question mark?

Thanks, Elizabeth Edwards.

Who I recall to be Juror No. 2.

I'll mark the note with a No. 1 in the upper right-hand corner for identification, and I'll hand the original note to the courtroom deputy.

Counsel, you can either discuss among yourselves what you think the code evidence should be, and if we can agree on a set of exhibits, I'll send them back. Or I'm happy to send the jury another note, and ask them to be more specific about what they're asking for, although I'm not particularly sure what we might get in response to that. I'm open to suggestions.

MR. FABRICANT: I don't remember a lot of code evidence in the record.

I don't remember a lot of exhibits with source code.

THE COURT: Well, before we all start talking at

12:14:11 1 one time, let's go off the record.

12:14:14 2 (Off-the-record discussion.)

12:19:38 3 THE COURT: All right. Let's go back on the  
12:19:40 4 record.

12:19:40 5 Counsel have met and conferred off the record with  
12:19:44 6 regard to an appropriate response to the jury's note.  
12:19:47 7 There seems to be an indication that there may be agreement  
12:19:50 8 between the parties as to how best to respond. I'm happy  
12:19:53 9 to hear from either or both sides on this.

12:19:53 10 MR. FABRICANT: Your Honor, we propose Plaintiff's  
12:19:56 11 Exhibit 1378 and Plaintiff's Exhibit 386.

12:19:59 12 And I believe defense counsel has agreed.

12:20:02 13 THE COURT: Give me those again, Mr. Fabricant.

12:20:05 14 MR. FABRICANT: Yes, Your Honor. 1378.

12:20:08 15 THE COURT: Plaintiff or Defendant?

12:20:09 16 MR. FABRICANT: Plaintiff. Plaintiff 1378 and  
12:20:14 17 Plaintiff 386.

12:20:19 18 THE COURT: All right. Mr. Hadden, Mr. Re, do you  
12:20:25 19 all agree with that?

12:20:27 20 MR. LAQUER: Defendants agree, Your Honor.

12:22:00 21 THE COURT: All right. You all have a seat then.

12:22:02 22 Counsel, here's a written version of my intended  
12:22:04 23 response based on what you just told me.

12:22:06 24 Members of the jury, in response to your note  
12:22:08 25 asking for, quote, code evidence, close quote, I am sending

12:22:13 1 you the following exhibits: PTX-1378 and PTX-386. Signed  
12:22:21 2 by me.

12:22:21 3 And we will attach those two Plaintiff's exhibits  
12:22:24 4 to this response.

12:22:25 5 Does Plaintiff have any objection to me sending  
12:22:30 6 this response and those exhibits to the jury?

12:22:33 7 MR. FABRICANT: No objection, Your Honor.

12:22:34 8 THE COURT: Any objection from Defendant?

12:22:35 9 MR. DACUS: No, Your Honor. Thank you.

12:22:37 10 THE COURT: Then I'll sign the original written  
12:22:40 11 response.

12:22:40 12 Ms. Lockhart, do you have those two exhibits?

12:22:43 13 COURTROOM DEPUTY: No, I haven't pulled them yet.

12:22:45 14 THE COURT: Let's get those two exhibits, please.

12:23:52 15 All right. I have those two physical exhibits. I  
12:23:56 16 have the printed and signed responsive note.

12:23:58 17 I will hand all of this to the Court Security  
12:24:00 18 Officer and direct him to deliver it to the jury.

12:24:02 19 All right. Counsel, pending either another note  
12:24:11 20 from the jury or the return of a verdict, we stand in  
12:24:13 21 recess.

12:24:14 22 I intend to start the bench trial in approximately  
12:24:18 23 30 minutes, at 1:00 o'clock.

12:24:20 24 We stand in recess.

12:24:22 25 COURT SECURITY OFFICER: All rise.

12:24:23 1 (Recess.)

12:31:38 2 (Jury trial.)

12:31:38 3 (Jury out.)

12:41:11 4 COURT SECURITY OFFICER: All rise.

12:41:12 5 THE COURT: Be seated, please.

01:00:54 6 Counsel, we have received a second note from the  
01:00:58 7 jury.

01:00:59 8 I will read it to you, and I'll mark it for  
01:01:04 9 identification and hand it to the courtroom deputy.

01:01:06 10 The second note reads as follows: Can we please  
01:01:10 11 see the Abutalebi patent, question mark? Thank you,  
01:01:21 12 Elizabeth Edwards.

01:01:22 13 I'll mark that for identification with a 2 in the  
01:01:25 14 upper right-hand corner and hand it to the courtroom  
01:01:27 15 deputy.

01:01:28 16 It appears to me, counsel, that what they're  
01:01:35 17 requesting is DTX-46, which is the patent application  
01:01:39 18 publication for this gentleman, whose last name I won't  
01:01:46 19 pronounce very well, so I won't try.

01:01:49 20 I have a prepared response to send to the jury  
01:01:51 21 with the actual exhibit, which reads as follows: Response  
01:01:56 22 to Jury Note No. 2. Members of the jury, in response to  
01:02:00 23 your second note, I am sending you DTX-46.

01:02:04 24 Is there any objection to that written response,  
01:02:07 25 together with the identified exhibit, being sent to the

01:02:10 1 jury from the Plaintiff?

01:02:12 2 MR. FABRICANT: No objection, Your Honor.

01:02:14 3 THE COURT: Defendant?

01:02:15 4 MR. DACUS: No, Your Honor.

01:02:17 5 THE COURT: I'll hand the signed note and the  
01:02:21 6 exhibit itself to the courtroom deputy, and direct him to  
01:02:24 7 deliver it to the jury in the jury room.

01:02:27 8 And since it is 1:00 o'clock, counsel,  
01:02:32 9 understanding that we may be interrupted with additional  
01:02:35 10 notes or a possible verdict by the jury, I see no reason  
01:02:38 11 not to go ahead and start the bench trial regarding  
01:02:40 12 Amazon's defense of inequitable conduct.

01:02:42 13 I am going to hold you to the time estimates you  
01:02:50 14 gave me earlier, so I'm expecting this should take no more  
01:02:55 15 than an hour and a half.

01:02:56 16 So, with that, Mr. Re, let me hear from you on  
01:03:01 17 behalf of the Defendants.

01:03:02 18 (Bench trial.)

01:03:02 19 MR. RE: Thank you, Your Honor. Mr. Re for the  
01:03:02 20 Amazon Defendants.

01:03:02 21 Amazon calls as its first witness on this bench  
01:03:05 22 trial on the subject of inequitable conduct Dr. Peter Li.

01:03:08 23 THE COURT: All right. Dr. Li, if you'll return  
01:03:11 24 to the witness stand. I remind you that you remain under  
01:03:16 25 oath from your earlier testimony in this trial. If you'll

01:03:22 1 just have a seat on the witness stand.

01:03:24 2 And, counsel, the Court's belief is that this  
01:03:31 3 witness is being called adversely, and the calling party  
01:03:35 4 should have the right to lead the witness.

01:03:37 5 MR. RE: Thank you, Your Honor.

01:03:37 6 QI "PETER" LI, DEFENDANTS' WITNESS, PREVIOUSLY SWORN

01:03:37 7 DIRECT EXAMINATION

01:03:38 8 BY MR. RE:

01:03:38 9 Q. Good afternoon, Dr. Li.

01:03:44 10 A. Good afternoon.

01:03:44 11 Q. We have a binder for you, should you want to see any  
01:03:50 12 original document.

01:04:25 13 Are you ready to begin?

01:04:27 14 A. Yes.

01:04:28 15 Q. Okay. When I was examining you last week, you and I  
01:04:35 16 discussed some patent applications that you filed back in  
01:04:38 17 2005 and 2006. Do you remember that?

01:04:42 18 A. Yes.

01:04:43 19 Q. And we talked about how those three applications  
01:04:48 20 disclose, for example, microphone arrays; do you remember  
01:04:51 21 that?

01:04:51 22 A. Yes.

01:04:52 23 Q. And those applications disclose microphone arrays with  
01:04:58 24 adaptive beamformers, noise reduction, and DSPs, right?

01:05:05 25 A. I don't remember exactly.



01:05:06 1 Q. Well, let's -- let's start with one.

01:05:09 2 MR. RE: Let's take a look at DTX-956, I believe  
01:05:12 3 it's Figure 2.

01:05:22 4 Q. (By Mr. Re) Do you recall this figure? I believe I  
01:05:24 5 showed it to you during the jury trial?

01:05:26 6 A. I can see that.

01:05:27 7 Q. And do you see how it discloses a DSP right in the  
01:05:31 8 center?

01:05:31 9 A. Yes.

01:05:33 10 Q. Do you recall this application?

01:05:37 11 A. I saw that.

01:05:41 12 Q. Do you see how this was published back in March of  
01:05:45 13 2007?

01:05:45 14 A. Yes.

01:05:48 15 Q. And do you recall how your applications also disclose  
01:05:56 16 an adaptive beamformer?

01:05:57 17 A. Can you point out?

01:05:59 18 Q. Let's show you DTX-955, Figure 6C.

01:06:09 19 Do you recall these figures I showed during the  
01:06:12 20 jury trial?

01:06:13 21 A. Yes.

01:06:14 22 Q. And, for example, I think during the jury trial, I  
01:06:18 23 emphasized Figure 6C. Do you see that?

01:06:21 24 A. Yes.

01:06:21 25 Q. Any doubt in your mind that that is showing an adaptive

01:06:26 1 beamformer on two sides of two different linear arrays?

01:06:29 2 A. This figure cannot prove this is using adaptive  
01:06:34 3 beamforming.

01:06:34 4 Q. My question is, is it -- does it show an adaptive  
01:06:40 5 beamformer shown with two linear arrays?

01:06:43 6 A. It's a two linear array, yes.

01:06:47 7 Q. Yes. And these applications that we discussed, it was  
01:06:50 8 three of them that we discussed during the jury trial, way  
01:06:53 9 before you filed your 2010 provisional, right?

01:06:55 10 A. Yes.

01:06:55 11 Q. And they were all published well before you filed your  
01:07:01 12 2010 provisional, right?

01:07:03 13 A. Yes.

01:07:04 14 Q. And these applications were filed by an attorney named  
01:07:09 15 Kayo Lu; is that right? Did I pronounce it right?

01:07:16 16 A. Yes.

01:07:16 17 Q. How do I pronounce his name?

01:07:19 18 A. Lu.

01:07:19 19 Q. Lu. And you remember Mr. Lu, right?

01:07:22 20 A. Yes.

01:07:23 21 Q. And you ultimately fired Mr. Lu, didn't you, as your  
01:07:32 22 patent attorney?

01:07:33 23 A. Yes.

01:07:33 24 Q. And you fired him, in part at least, because he did not  
01:07:37 25 keep you informed of the patent prosecution with the Patent

01:07:43 1 Office, right?

01:07:44 2 A. Right.

01:07:44 3 Q. And, in fact, you had to at one time filed a petition  
01:07:50 4 to revive one of these abandoned patent applications,  
01:07:53 5 right?

01:07:53 6 A. I don't remember.

01:07:59 7 Q. Let's -- let's show it to refresh your recollection.

01:08:04 8 MR. RE: It's DTX-957.

01:08:15 9 Q. (By Mr. Re) And do you see how this was -- do you  
01:08:18 10 recognize this document?

01:08:18 11 A. I know this document is regard -- regarding to -- to  
01:08:29 12 that patent application.

01:08:29 13 Q. Yes. And you filed what I would call a petition to  
01:08:34 14 revive an abandoned application; isn't that right?

01:08:38 15 A. Yes.

01:08:39 16 Q. And, in it, you explained some of the troubles you were  
01:08:42 17 having with your patent attorney, right? And you can look  
01:08:47 18 at the original if you'd like.

01:08:49 19 A. I don't remember detail of this documentation.

01:08:53 20 Q. But do you remember explaining to the Patent Office  
01:08:58 21 that your lawyer was doing a poor job for the money you  
01:09:01 22 were paying him because he was not keeping you informed  
01:09:06 23 with the information to and from the Patent Office, right?

01:09:09 24 A. Yes.

01:09:10 25 Q. And you ended up hiring the law firm -- by June of

01:09:15 1 2009, you hired the law firm of Kenyon & Kenyon; is that  
01:09:19 2 right?

01:09:19 3 A. Yes.

01:09:23 4 Q. And, by 2010, all three of these applications that you  
01:09:27 5 prosecuted with Mr. Lu had been abandoned, though they were  
01:09:34 6 all published, right?

01:09:35 7 A. Right.

01:09:35 8 Q. And after you hired Kenyon & Kenyon, you then hired  
01:09:40 9 Mr. Tankha; isn't that right?

01:09:42 10 A. Yes.

01:09:42 11 Q. And do you recall hiring Mr. Tankha?

01:09:44 12 A. Yes.

01:09:47 13 Q. And when you hired Mr. Tankha, did you know that he had  
01:09:52 14 been accused in public filings of committing acts of  
01:09:54 15 inequitable conduct?

01:09:55 16 A. No.

01:09:57 17 Q. To this day, are you aware of the fact that allegations  
01:10:01 18 have been made against Mr. Tankha for acts of inequitable  
01:10:07 19 conduct?

01:10:07 20 A. No -- I don't know.

01:10:10 21 Q. Do you know what is inequitable conduct? Do you have  
01:10:13 22 any understanding?

01:10:14 23 A. I have no knowledge of that.

01:10:16 24 Q. I'd like to show you Exhibit DTX-857 -- I mean, 852, in  
01:10:26 25 particular. And, particularly, I'd like to show you

01:10:32 1 Page 6, Paragraph 46 of this document.

01:10:46 2 Were you aware of the fact that in this litigation  
01:10:49 3 of Exhibit 852, that Mr. Ashok Tankha was alleged to have  
01:10:58 4 committed inequitable conduct and/or unclean hands by  
01:11:01 5 making material misrepresentations and by withholding  
01:11:04 6 material information with the intent to deceive the USPTO  
01:11:09 7 during prosecution of what is referred to here as the '303  
01:11:16 8 application and/or each of the continuing applications  
01:11:18 9 claiming priority to the '303 application, including  
01:11:22 10 another patent, the '698 patent?

01:11:26 11 Were you aware of any of this?

01:11:28 12 A. Could you explain?

01:11:29 13 Q. Were you aware of any of these allegations that were  
01:11:33 14 made against your lawyer, Mr. Tankha, at any time?

01:11:36 15 A. No.

01:11:39 16 Q. So this is the first time you've heard of this?

01:11:42 17 A. Right.

01:11:43 18 Q. Okay. And you know -- and you've had lots of patent  
01:11:48 19 applications. Do you have any idea of how many patent  
01:11:52 20 applications you think you've filed in your lifetime at the  
01:11:55 21 United States Patent and Trademark Office?

01:11:56 22 THE COURT: Slow down, Mr. Re.

01:12:00 23 Q. (By Mr. Re) Do you -- do you know how many  
01:12:02 24 applications you think you've filed in the Patent Office,  
01:12:04 25 just approximately?

01:12:04 1 A. I know I filed many patent applications.

01:12:07 2 Q. Right. And you're familiar with different kinds of  
01:12:11 3 patents, right?

01:12:11 4 A. Could you repeat?

01:12:12 5 Q. You're familiar with the different types of patents  
01:12:15 6 that the Patent Office gives, right?

01:12:17 7 A. Yes.

01:12:17 8 Q. And, for example, when you visited Amazon, you had two  
01:12:24 9 patents when you visited, right?

01:12:25 10 A. Correct.

01:12:26 11 Q. And, remember, those were design patents only, right?

01:12:28 12 A. Yes.

01:12:29 13 Q. And so -- and then you had 13 other pending patents,  
01:12:35 14 you represented, to Amazon at the 2011 meeting, right?

01:12:38 15 A. Yes.

01:12:38 16 Q. And this was almost 10 years ago, so you -- you're a  
01:12:44 17 pretty experienced patent filer, aren't you?

01:12:50 18 A. I filed patents.

01:12:52 19 Q. But lots of them of them, right?

01:12:56 20 A. What's the definition of a lot? How many is a lot?

01:12:58 21 Q. Dozens?

01:12:59 22 A. Yes.

01:13:00 23 Q. Okay. And you're still filing -- to this day, you're  
01:13:04 24 still filing reissue -- reissue applications, you're still  
01:13:07 25 amending claims, and signing many, many documents before

01:13:09 1 the USPTO, right?

01:13:10 2 A. What's a number of many, many?

01:13:13 3 Q. Dozens, right?

01:13:14 4 A. Dozens?

01:13:17 5 Q. Dozens, like dozens, meaning --

01:13:21 6 A. Dozens.

01:13:22 7 Q. -- many 12's? Yes. Okay. Many -- just -- the number  
01:13:28 8 is really not that important. I just want to show --

01:13:30 9 A. Could you repeat your question?

01:13:32 10 Q. Yes. So you have filed many papers with the Patent  
01:13:39 11 Office where you sign your name? Do you recall that?

01:13:41 12 A. Yes.

01:13:41 13 Q. And we saw some of those during the jury trial, right?

01:13:44 14 A. Yes.

01:13:44 15 Q. And so -- and you also know from signing these  
01:13:50 16 documents that there are consequences for not being  
01:13:52 17 truthful and honest, right?

01:13:54 18 A. What's the meaning of consequences?

01:13:57 19 Q. I think we heard about even imprisonment in this case  
01:14:02 20 for misleading or false statements to the Patent Office.

01:14:05 21 Are you aware of that?

01:14:06 22 A. I never try to mislead the Patent Office.

01:14:14 23 Q. Okay. I wasn't suggesting that. You're familiar with  
01:14:17 24 the importance of not misleading the Patent Office, right?

01:14:20 25 A. Yes, that's important.

01:14:21 1 Q. Very important, right?

01:14:22 2 A. Yes.

01:14:23 3 Q. And you knew when you filed for the -- what became the

01:14:29 4 '756 patent and the '049, when you filed those

01:14:32 5 applications, you knew that you had a duty to disclose

01:14:37 6 information which is material to patentability, right?

01:14:40 7 A. Yes.

01:14:44 8 Q. Yes. And, in fact, you signed inventor declarations to

01:14:48 9 that effect, right?

01:14:49 10 A. Yes.

01:14:55 11 Q. And you signed declarations with regard to the '756 and

01:14:59 12 '049 applications that specifically alert you to the duty

01:15:02 13 to disclose all material information to patentability,

01:15:08 14 right?

01:15:08 15 A. I signed all required document.

01:15:11 16 Q. Well, let's take a look at the required document for

01:15:14 17 the conversion of your provisional application to make it a

01:15:18 18 real application, right? I'm going to show you.

01:15:22 19 MR. RE: Let's show PTX-4.176.

01:15:33 20 Q. (By Mr. Re) And if we could just go to where your

01:15:36 21 acknowledgement statement is -- down the page.

01:15:39 22 MR. RE: And there it is. Stop where it says "I

01:15:44 23 acknowledge."

01:15:44 24 Q. (By Mr. Re) And do you realize that when you sign

01:15:46 25 these forms, that you acknowledge the duty to disclose



01:15:50 1 information which is material to patentability as  
01:15:53 2 defined -- as defined by 37 CFR 1.56? Do you see that?

01:15:59 3 A. Yes.

01:16:00 4 Q. And you understood that you had this duty when you  
01:16:12 5 signed this document, which is Exhibit 4.176, right? You  
01:16:19 6 knew that, right?

01:16:19 7 A. Referring to patent application?

01:16:21 8 Q. Yeah, this -- this one in particular. This is the oath  
01:16:24 9 you signed to file -- to actually file the '756 patent  
01:16:29 10 application in 2011, right?

01:16:33 11 A. I think so. You didn't show me -- you only show me  
01:16:38 12 part of that. I didn't see the title.

01:16:39 13 Q. Okay. You have a book, if you want to see the  
01:16:43 14 original, but we'll show you the top.

01:16:45 15 MR. RE: Mr. Berk, can we just blow up the top of  
01:16:51 16 this document?

01:16:51 17 A. Okay. I saw the title marked declaration.

01:16:55 18 Q. (By Mr. Re) And you see the declaration you're making  
01:16:58 19 along with your co-inventor Manli Zhu?

01:17:00 20 A. Yes.

01:17:01 21 Q. And you're aware of this oath because you have signed  
01:17:03 22 this oath many, many times with respect to each and every  
01:17:06 23 one of the patent applications where you are a named  
01:17:09 24 inventor, correct?

01:17:10 25 A. If we show application, we sign this, yes.

01:17:14 1 Q. And you're aware of the significance of this oath,  
01:17:18 2 aren't you?

01:17:18 3 A. Could -- could you repeat?

01:17:29 4 Q. You're aware of the significance, the importance of  
01:17:32 5 this oath?

01:17:33 6 A. Yes.

01:17:38 7 Q. Okay. And you understood when you signed the oath on  
01:17:40 8 these applications, that a reference that discloses the  
01:17:43 9 limitations of your claims should be disclosed to the  
01:17:51 10 Patent Office, right?

01:17:51 11 A. Yes.

01:17:52 12 Q. And you realized you had that obligation when you filed  
01:17:58 13 for your reissue application, which became the '049 patent,  
01:18:01 14 correct?

01:18:01 15 A. Yes.

01:18:02 16 Q. And when you filed applications, did you ever tell your  
01:18:08 17 patent lawyer about your earlier patent applications which  
01:18:11 18 had all been rejected but published by the Patent Office?

01:18:20 19 A. I don't remember, but --

01:18:25 20 Q. You don't remember?

01:18:26 21 A. Let me finish.

01:18:28 22 I have a personal website, list all the patents  
01:18:36 23 and the references, published paper, and the book. And he  
01:18:41 24 has the access to that -- to my personal website for all  
01:18:45 25 the information.

01:18:47 1 Q. And so you -- did you expect your lawyer to go on your  
01:18:52 2 website, to go through all your listings and your  
01:18:55 3 references, in order for him to find out what he should  
01:18:59 4 determine is material to your claimed inventions?

01:19:02 5 A. Just -- just website -- just a part of the source of  
01:19:06 6 references. We also gave everything we believe that's  
01:19:11 7 related to the patent application to our patent attorney.

01:19:16 8 Q. I understand. But what I'm getting at is did you  
01:19:20 9 expect your patent lawyer to go on your website to learn  
01:19:23 10 for himself what he should disclose?

01:19:25 11 A. We may refer him -- for example, instead of an email  
01:19:36 12 document which is too long, we may refer our patent  
01:19:42 13 attorney to follow the document or reference from the  
01:19:46 14 web -- website, since that would be easier.

01:19:49 15 Q. And do you have any recollection of giving to your  
01:19:54 16 patent lawyer any of the published patent applications that  
01:19:59 17 you had previously filed but were rejected by the Patent  
01:20:02 18 Office and in the public domain?

01:20:04 19 A. I don't remember.

01:20:06 20 Q. Do you have any recollection of telling your patent  
01:20:10 21 lawyer, oh, go look on my website for additional materials,  
01:20:15 22 and you decide what to disclose?

01:20:17 23 A. We submit everything to our patent attorney. It's up  
01:20:24 24 to him.

01:20:25 25 Q. Okay. And you do see, particularly from this trial and

01:20:29 1 from looking at your '049 patent, that your prior patent  
01:20:34 2 applications and publications that we discussed during this  
01:20:38 3 trial, none of them were disclosed to the Patent Office?  
01:20:41 4 You know that, right?

01:20:42 5 A. Again, it's up to our patent attorney to decide which  
01:20:49 6 one -- which reference to submit to the Patent Office.

01:20:53 7 Q. But you -- my question is, do you know, sitting here  
01:20:56 8 today, and have you confirmed in your own mind, that none  
01:21:00 9 of those patent applications had been disclosed to the  
01:21:03 10 Patent Office?

01:21:05 11 A. I don't have the patent particularly in front of me.  
01:21:15 12 That's many pages of documentation. Maybe not. But, you  
01:21:23 13 know, you want to find out now?

01:21:25 14 Q. No --

01:21:26 15 A. I can take a look -- I can take a look at '049 patent  
01:21:30 16 and give you answer.

01:21:32 17 Q. You could tell if your applications were disclosed by  
01:21:35 18 just looking at the '049?

01:21:36 19 A. I -- okay. I submit everything we think is related to  
01:21:45 20 our patent attorney.

01:21:47 21 Q. I understand that's your testimony.

01:21:49 22 What I'm trying to figure out, as you sit here  
01:21:55 23 today, do you have any belief whatsoever that any of those  
01:22:00 24 publications, which were abandoned patent applications,  
01:22:02 25 were disclosed in either the '756 or '049 patents?

01:22:04 1 A. I don't remember.

01:22:07 2 Q. Okay. Okay.

01:22:07 3 A. I remember I -- we did submit everything.

01:22:10 4 Q. Well, you keep saying you submitted everything. But  
01:22:14 5 your testimony is you might have given them to your patent  
01:22:17 6 lawyer, but you don't know what he disclosed?

01:22:19 7 A. Right. We submit everything to our patent attorney,  
01:22:25 8 and he made the decision.

01:22:26 9 Q. And when you say "we," I just want to make sure we're  
01:22:30 10 clear on what people we're talking about. Who are the "we"  
01:22:33 11 in that sentence you just gave?

01:22:34 12 A. I, Dr. Manli Zhu.

01:22:39 13 Q. And were you and Dr. Zhu the only sources of  
01:22:42 14 information to Mr. Tankha?

01:22:47 15 A. I don't remember how many people from my company submit  
01:22:59 16 references to our patent attorneys.

01:23:04 17 Q. So you don't recall if it's anyone else, other than you  
01:23:07 18 and Dr. Zhu?

01:23:09 19 A. It's possible other people also submitted references to  
01:23:16 20 our patent attorney.

01:23:17 21 Q. But do you have any recollection of anyone else  
01:23:20 22 actually doing so?

01:23:21 23 A. I don't remember who did that, but it's very possible  
01:23:28 24 there are other people do that.

01:23:30 25 Q. Now, you -- you testified and you recall filing the

01:23:35 1 provisional in this case that was filed in 2010? Do you  
01:23:41 2 recall that?

01:23:42 3 A. Yes.

01:23:43 4 Q. And Mr. Tankha prepared your 2010 provisional, right?

01:23:59 5 A. I don't remember who submitted the provisional.

01:24:12 6 Q. My question was, do you -- and I think you testified  
01:24:15 7 already that Mr. Tankha prepared that provisional  
01:24:19 8 application, right?

01:24:23 9 A. You know, I don't remember since sometime we submit a  
01:24:30 10 provisional by ourselves, sometime through our patent  
01:24:33 11 attorney.

01:24:34 12 Q. But didn't you testify in front of the jury that this  
01:24:38 13 original provisional was prepared by your attorney? Do you  
01:24:42 14 remember that?

01:24:49 15 A. If I said that then, yeah.

01:25:04 16 Q. Well, you did, didn't you?

01:25:05 17 A. I don't recall.

01:25:09 18 Q. And you --

01:25:13 19 A. Specifically, you know, for this specific question  
01:25:15 20 you're asking me.

01:25:16 21 Q. And -- and you recall that you approved the filing of  
01:25:23 22 the provisional application, right?

01:25:24 23 A. I have to sign that.

01:25:26 24 Q. And you -- and you listed some references at the end of  
01:25:33 25 the provisional application, right?

01:25:35 1 A. Yes.

01:25:37 2 Q. And one of those references you listed in your 2010  
01:25:41 3 provisional was the 2001 Brandstein textbook, right?

01:25:48 4 A. Yes.

01:25:49 5 Q. And you must have believed back then that the  
01:25:55 6 Brandstein textbook was relevant; that's why you cited it  
01:26:00 7 at the end of your provisional. Right?

01:26:02 8 A. That's what I believe is a reference.

01:26:09 9 Q. And you also stated during this jury trial that it's  
01:26:13 10 pretty clear that your attorney used Brandstein when he  
01:26:16 11 prepared your provisional patent application, right?

01:26:23 12 A. He didn't tell me this. I don't remember. You know,  
01:26:28 13 he was -- say it this way, how he prepared our patent  
01:26:33 14 application, it is his job, right?

01:26:37 15 Q. Yes. But during this trial, I asked you this  
01:26:42 16 question -- just tell me if I read it right.

01:26:45 17 Does this make it a little more clear to you that  
01:26:48 18 the author of the patent application did, in fact, open and  
01:26:54 19 use the Brandstein book when the application was written?

01:26:59 20 And you said: Yes.

01:27:02 21 So --

01:27:03 22 A. Okay. From my study, the other -- at the time you  
01:27:10 23 asked me the question, that author could be Dr. Manli Zhu.

01:27:16 24 Q. And did you give the Brandstein book to your patent  
01:27:20 25 attorney?

01:27:20 1 A. I don't remember exactly. I believe we gave everything  
01:27:26 2 to our patent attorney.

01:27:28 3 Q. But you have no recollection of giving your patent  
01:27:32 4 attorney the Brandstein book, right?

01:27:33 5 A. I don't remember.

01:27:34 6 Q. And do you know that in this case, we have exchanged  
01:27:40 7 documents concerning your patent prosecution?

01:27:43 8 A. I believe so.

01:27:46 9 Q. And do you know we were given emails when you would  
01:27:56 10 transmit references to Mr. Tankha; do you know that?

01:27:58 11 A. I think that's up to our attorney what kind of  
01:28:04 12 information to give to you.

01:28:06 13 Q. But I'm asking about what you gave the attorney. You  
01:28:09 14 have no record or recollection of giving the attorney the  
01:28:14 15 Brandstein book at any time, do you?

01:28:16 16 A. I don't remember.

01:28:17 17 Q. And, in fact --

01:28:19 18 THE COURT: Wait a minute, are we talking about  
01:28:20 19 the patent prosecution attorney, or are we talking about  
01:28:23 20 the trial attorney that's here today?

01:28:25 21 MR. RE: Thank you.

01:28:26 22 Q. (By Mr. Re) We're talking about Mr. Tankha, the patent  
01:28:27 23 prosecution attorney, right?

01:28:29 24 A. Okay.

01:28:29 25 Q. And you have no recollection of giving the Brandstein



01:28:33 1 book to Mr. Tankha?

01:28:39 2 A. Remember what you said, we gave the reference in our  
01:28:45 3 provisional? And when he filed official patent  
01:28:54 4 application, he must use the provisional, right?

01:29:00 5 Q. So you know that your patent lawyer used the  
01:29:04 6 provisional when writing your real, official patent  
01:29:08 7 application, right?

01:29:10 8 A. Based on my comments.

01:29:14 9 Q. And you know, as you sit here today, that the  
01:29:18 10 Brandstein book was not, in fact, given to the Patent  
01:29:20 11 Office during the prosecution of either the '756 patent or  
01:29:24 12 the '049 patent, right?

01:29:28 13 A. Again, it's our patent attorney's decision.

01:29:31 14 Q. And your patent attorney must have removed, removed the  
01:29:36 15 information concerning Brandstein when he filed the  
01:29:39 16 official patent application, even though he had Brandstein  
01:29:45 17 in the provisional, right?

01:29:48 18 A. What he did is his job.

01:29:55 19 Q. I now want to move on to your article.

01:29:57 20 And you also know that you and Dr. Zhu published  
01:30:03 21 an article in 2009, right? We talked about it during the  
01:30:09 22 trial?

01:30:09 23 A. Yes.

01:30:10 24 Q. And, in fact -- we can call it up -- it's DTX-14,  
01:30:19 25 right? And at the end of your article, do you see how you

01:30:22 1 have --

01:30:22 2 A. Okay.

01:30:23 3 Q. You remember this?

01:30:23 4 A. Yeah, this sounds right.

01:30:25 5 Q. Okay. And let's go to your list of references listed  
01:30:28 6 in your 2009 article; do you see that?

01:30:33 7 A. Yes.

01:30:34 8 Q. And do you see what you listed as Reference No. 4?

01:30:38 9 A. Yes.

01:30:47 10 Q. And you listed the book Brandstein and Ward, Microphone  
01:30:55 11 Arrays, Springer, 2001. That's the whole book you're  
01:30:58 12 citing, right?

01:30:59 13 A. Yes.

01:30:59 14 Q. And you gave the Li -- this Li article, and you knew --  
01:31:04 15 now, you knew about Brandstein, obviously, before 2009,  
01:31:07 16 right?

01:31:07 17 A. Could you pull up the reference number?

01:31:15 18 Q. Reference No. 4, doesn't this establish that you and  
01:31:19 19 Dr. Zhu knew about the Brandstein award book before you  
01:31:21 20 published this article in April of 2009, right?

01:31:23 21 A. We knew about that book.

01:31:25 22 Q. Yes. But you gave this article to your patent lawyer,  
01:31:29 23 didn't you?

01:31:32 24 A. We gave everything.

01:31:33 25 Q. I'm asking about the article. Do you know that you

01:31:39 1 gave this article, your Li and Zhu article, to Mr. Tankha?

01:31:44 2 A. Yes, as we remember, we gave everything.

01:31:48 3 Q. And you did not give this article to your patent lawyer

01:31:52 4 until February of 2013; isn't that right?

01:31:58 5 A. It's up to him.

01:32:00 6 MR. RE: Let's show a new exhibit, Your Honor.

01:32:03 7 DTX-32, this has not been yet used in the trial.

01:32:08 8 I move it into evidence.

01:32:11 9 Q. (By Mr. Re) Do you recall in any of your preparation

01:32:14 10 DTX-32?

01:32:15 11 A. Uh-huh.

01:32:20 12 THE COURT: Dr. Li.

01:32:23 13 A. That's my email.

01:32:25 14 THE COURT: You're going to have to answer

01:32:29 15 verbally.

01:32:30 16 THE WITNESS: I just -- I was reading.

01:32:31 17 A. Yes.

01:32:32 18 Q. (By Mr. Re) When was the last time you saw this

01:32:34 19 exhibit?

01:32:34 20 A. This email?

01:32:35 21 Q. Yes.

01:32:35 22 A. I don't remember when I saw that --

01:32:37 23 Q. Okay.

01:32:37 24 A. -- last time. But that looks like it's my email.

01:32:43 25 Q. It is your email, right?

01:32:45 1 A. Yes.

01:32:45 2 Q. And this is the cover email where you sent to your  
01:32:47 3 patent lawyer your Li and Zhu article on February 16th,  
01:32:54 4 2013, right?

01:32:56 5 A. Yes.

01:32:59 6 MR. RE: And, in fact, if we can show DTX-33, the  
01:33:03 7 attachment to DTX-32.

01:33:05 8 Q. (By Mr. Re) Do you recognize DTX-33?

01:33:10 9 A. Yes.

01:33:10 10 Q. And this is the article that was attached to your  
01:33:13 11 email, right?

01:33:13 12 A. Yes.

01:33:17 13 Q. And -- and you testified during this trial that this  
01:33:19 14 article discloses microphone arrays and DSP, right?

01:33:22 15 A. Yes.

01:33:25 16 Q. And you testified during this trial this article  
01:33:28 17 discloses a beamforming unit and a noise reduction unit  
01:33:30 18 implemented in the DSP, right?

01:33:32 19 A. Yes.

01:33:38 20 Q. And you obviously sent this to your lawyer because you  
01:33:41 21 thought it was relevant to the prosecution of your patent,  
01:33:47 22 right?

01:33:47 23 A. Yes.

01:33:47 24 Q. And you expected your patent --

01:33:49 25 A. Hold on.

01:33:50 1 THE COURT: Just a minute.

01:33:52 2 Let me make a suggestion, Mr. Re. Given Dr. Li's  
01:33:57 3 clear challenges with the English language, if you could  
01:34:01 4 make sure you pause so that he has -- he apparently has  
01:34:10 5 some answers that take a little extra time to get out, and  
01:34:15 6 you've moved on to the middle of the next question, and it  
01:34:17 7 gets confusing.

01:34:18 8 If we could make sure there's a break, so in case  
01:34:21 9 with his communication struggles, he has more of an answer  
01:34:27 10 that immediately comes out, we can get it all in the  
01:34:31 11 record. Can we do that?

01:34:32 12 MR. RE: Yes, we can.

01:34:33 13 THE COURT: Okay. Thank you.

01:34:35 14 A. Could you repeat your question?

01:34:38 15 Q. (By Mr. Re) Yes. And you thought that this article  
01:34:41 16 had relevance to your patent application, and that's why  
01:34:47 17 you sent it to your patent lawyer in February of 2013,  
01:34:53 18 right?

01:34:53 19 A. In term of contents, this article is different than our  
01:35:00 20 '049 patent. The term of microphone array, they both talk  
01:35:05 21 about microphone array.

01:35:05 22 Q. So you gave it to your patent lawyer hoping he would  
01:35:12 23 submit it presumably on the '756, right?

01:35:15 24 A. Again, it's our patent attorney's decision.

01:35:17 25 Q. Right. And you gave the decision to him for him to

01:35:22 1 decide whether or not to disclose it, right?

01:35:24 2 A. Right. I'm not an attorney.

01:35:29 3 Q. And did you know that your attorney was telling the  
01:35:36 4 Patent Office that the '756 application should be allowed  
01:35:40 5 because the prior art does not disclose the delay  
01:35:44 6 limitation we've been talking about so much in this trial?

01:35:47 7 A. Could you repeat your question?

01:35:52 8 Q. Did you know in this time frame, 2013 when the '756 was  
01:36:00 9 being -- when we say "prosecuted," do you know that word,  
01:36:05 10 "prosecuted"?

01:36:08 11 A. Which year?

01:36:18 12 Q. 2013. The patent issued October 2014, right?

01:36:18 13 A. Yeah.

01:36:20 14 Q. So your attorney was arguing why you should get a  
01:36:22 15 patent. You know that, right?

01:36:24 16 A. Yeah.

01:36:25 17 Q. And you know that your attorney was filing papers  
01:36:28 18 making representations to the Patent Office why you deserve  
01:36:31 19 a patent. You know that, right?

01:36:33 20 A. I don't remember detail, but he must submit some Office  
01:36:45 21 Actions.

01:36:45 22 Q. And you were communicating with your lawyer throughout  
01:36:49 23 the prosecution of your patents, right?

01:36:56 24 A. We may.

01:36:59 25 Q. Yes.

01:37:01 1 MR. RE: And, in fact, in this case, I'd like to  
01:37:02 2 offer as an exhibit, Exhibit DTX-834, which is the  
01:37:08 3 privilege log from this matter.

01:37:19 4 Q. (By Mr. Re) Do you know what the privilege log is?

01:37:29 5 A. Which log?

01:37:31 6 MR. RE: If we can turn some pages of Exhibit 834.

01:37:34 7 Q. (By Mr. Re) Do you see how this is listing all of the  
01:37:39 8 communications you were having with Mr. Tankha throughout  
01:37:42 9 the prosecution of your patents? Do you understand that?

01:37:47 10 A. That's the first time I see this table.

01:37:51 11 Q. And you do recall getting communications from your  
01:37:56 12 patent lawyer throughout the prosecution of your patent  
01:38:00 13 applications, right?

01:38:02 14 A. Yes. We have -- we had communications.

01:38:05 15 Q. Yes. And you -- you were very sensitive to that,  
01:38:10 16 because you fired your last patent lawyer who was not  
01:38:13 17 communicating with you regularly, which led to your  
01:38:16 18 abandoned patent applications earlier, right?

01:38:18 19 A. The reason I fired the last attorney because he did not  
01:38:26 20 forward the Patent Office, Office Action document to me.

01:38:32 21 Q. Right. But this lawyer, Mr. Tankha, seems to do a very  
01:38:36 22 good job at sending you the communications from the Patent  
01:38:40 23 Office to you and Dr. Zhu and Craig Adams, right?

01:38:46 24 A. He did.

01:38:48 25 Q. Yes.

01:38:58 1 MR. RE: I have no further questions, Your Honor.

01:39:02 2 Thank you.

01:39:02 3 THE COURT: Cross-examination?

01:39:10 4 MR. FABRICANT: May I proceed, Your Honor?

01:39:12 5 THE COURT: You may.

01:39:12 6 CROSS-EXAMINATION

01:39:14 7 BY MR. FABRICANT:

01:39:14 8 Q. Good afternoon, Dr. Li.

01:39:18 9 A. Hi. Good afternoon.

01:39:19 10 Q. You were shown a redacted email a few minutes ago dated  
01:39:27 11 2013, in which there was a reference to your 2009 article?

01:39:31 12 A. Yes.

01:39:32 13 Q. As you sit here today, do you know whether you had  
01:39:35 14 forwarded that article to him previously, in prior years?

01:39:40 15 A. You know, I believe we submit everything, including  
01:39:46 16 article, to our patent attorneys. And the email showed  
01:39:51 17 that one, we may send again.

01:39:56 18 Q. The article from 2009 that you co-authored with  
01:40:02 19 Dr. Zhu --

01:40:02 20 A. Yes.

01:40:03 21 Q. -- with respect to that article, does that article, as  
01:40:07 22 you authored it, disclose adaptive beamforming, Dr. Li?

01:40:13 23 A. In the article, there's no adaptive beamforming.  
01:40:21 24 There's no sound source localization.

01:40:24 25 Q. And you were asked about delay. Is the type of delay



01:40:27 1 referenced in your article different because it's a fixed  
01:40:32 2 beam rather than an adaptive beam?

01:40:38 3 MR. RE: Leading, Your Honor.

01:40:43 4 A. Okay.

01:40:44 5 THE COURT: Just a minute, Dr. Li.

01:40:45 6 It is technically leading, but this is before the  
01:40:48 7 Court. And given the challenges this witness has with  
01:40:53 8 English as a spoken language, I'm going to allow some  
01:40:56 9 latitude.

01:40:57 10 MR. FABRICANT: Thank you.

01:41:02 11 THE COURT: Rephrase your question, Mr. Fabricant.

01:41:04 12 MR. FABRICANT: Yes, I will. Yes, I will,  
01:41:07 13 Your Honor.

01:41:07 14 Q. (By Mr. Fabricant) Can you tell the Court how the type  
01:41:10 15 of delay, which is set forth in your article with respect  
01:41:14 16 to the CrispMic I, compares to the type of delay  
01:41:19 17 calculations regarding your '049 invention?

01:41:22 18 A. That's different. The first one is a fixed  
01:41:27 19 beamforming. The second one is adaptive beamforming.

01:41:29 20 Q. And is the way of the delay determined different  
01:41:32 21 because of the different type of beamformers?

01:41:35 22 A. That's right.

01:41:35 23 Q. In the patent that issued from the '049, the actual  
01:41:47 24 patent -- and I think it's PTX-1 -- do you know whether the  
01:41:55 25 provisional application which led to the '756, which led to

01:42:03 1 the '042 [sic], is in the '049 patent incorporated by  
01:42:10 2 reference in the file history as part of the public record?  
01:42:13 3 Do you know that?  
01:42:14 4 A. Yes.  
01:42:15 5 Q. And is it?  
01:42:15 6 A. It means that the provisional -- I saw that provisional  
01:42:20 7 application number and the time.  
01:42:22 8 Q. My question to you is, if someone in the public looks  
01:42:25 9 at the file history --  
01:42:26 10 A. Yes.  
01:42:27 11 Q. -- of the '049, they will see the provisional, and they  
01:42:31 12 will see the reference to the Brandstein book, will they  
01:42:35 13 not?  
01:42:35 14 A. I don't think the public can see the provisional,  
01:42:38 15 right?  
01:42:38 16 Q. No, I'm asking you about the '049.  
01:42:40 17 A. Yeah.  
01:42:41 18 Q. Which incorporates by reference the provisional, which  
01:42:45 19 is in the whole file wrapper, which is available to the  
01:42:47 20 public today. Anyone reading that can see that there was a  
01:42:49 21 reference to the Brandstein book, could they not?  
01:42:51 22 A. Yes.  
01:42:52 23 MR. RE: Leading, Your Honor.  
01:43:00 24 THE COURT: I'll allow that question, but  
01:43:02 25 Mr. Fabricant, when I said some latitude, I didn't mean

01:43:06 1 unlimited latitude.

01:43:07 2 MR. FABRICANT: Yes, Your Honor.

01:43:08 3 THE COURT: Let's proceed.

01:43:09 4 Q. (By Mr. Fabricant) I'll rephrase it for you, Doctor.

01:43:13 5 Do you know one way or the other, if you pull the  
01:43:15 6 entire file wrapper today of the '049, whether you find the  
01:43:18 7 provisional application in the file history?

01:43:23 8 A. People should be able to see that.

01:43:28 9 MR. FABRICANT: No further questions. I pass the  
01:43:30 10 witness, Your Honor.

01:43:30 11 THE COURT: Redirect?

01:43:30 12 REDIRECT EXAMINATION

01:43:32 13 BY MR. RE:

01:43:32 14 Q. You -- you paid attention throughout this trial, didn't  
01:43:38 15 you? Did you pay attention?

01:43:40 16 A. Yes.

01:43:40 17 Q. And you listened to the questions and answers that were  
01:43:42 18 given to Dr. Zhu?

01:43:52 19 A. Yes.

01:43:53 20 Q. And you don't disagree with anything Dr. Zhu said about  
01:43:56 21 the Li and Zhu article, do you?

01:43:59 22 A. Dr. Zhu said many things.

01:44:01 23 Q. Do you recall Dr. Zhu agreeing that the delay

01:44:05 24 calculation -- I believe she was answering questions of

01:44:07 25 Mr. Hadden -- that the delay calculation in the article is

01:44:11 1 the same one that's set forth in Limitation 1[C] of

01:44:16 2 Claim 1?

01:44:19 3 A. Okay.

01:44:19 4 Q. Do you recall that?

01:44:20 5 A. I -- I don't recall what Dr. Zhu said. But if it's

01:44:27 6 calculate delay for the linear array. And you remember

01:44:32 7 said in '049, also talk about linear array, fixed

01:44:38 8 beamforming. If linear array, fixed beamforming the -- the

01:44:43 9 way to calculate a delay could be the same.

01:44:46 10 Q. And that's what Dr. Zhu said about the delay

01:44:48 11 limitation, right?

01:44:52 12 A. I don't remember exactly what Dr. Zhu said. I just

01:44:56 13 tell you my understanding of that terminology.

01:45:01 14 Q. And you also understand that your '756 and your '049,

01:45:06 15 both of those also claimed a linear array, right?

01:45:14 16 A. A linear array, so one of the arrays in '049 patent.

01:45:18 17 Q. In the claim, right? It can be circular, linear, or

01:45:23 18 any other configuration, right?

01:45:25 19 A. You are right.

01:45:26 20 Q. Thank you very much, Dr. Li. It's been a pleasure.

01:45:29 21 THE COURT: I gather you pass the witness, Mr. Re?

01:45:32 22 MR. RE: I pass the witness.

01:45:33 23 THE COURT: Do you have further cross,

01:45:35 24 Mr. Fabricant?

01:45:35 25 MR. FABRICANT: No further cross, Your Honor.

01:45:37 1 THE COURT: All right. You may step down, Dr. Li.

01:45:40 2 Mr. Re, call your next witness.

01:45:44 3 MS. DOAN: Your Honor, Amazon calls Mr. Nicholas

01:45:49 4 Godici.

01:45:49 5 THE COURT: All right. If you'll come forward,

01:45:52 6 sir, and be sworn.

01:46:04 7 (Witness sworn.)

01:46:05 8 THE COURT: Please come around, have a seat on the

01:46:14 9 witness stand.

01:46:15 10 Ms. Doan, you may proceed.

01:46:43 11 MS. DOAN: Thank you, Your Honor.

01:46:43 12 NICHOLAS GODICI, DEFENDANTS' WITNESS, SWORN

01:46:43 13 DIRECT EXAMINATION

01:46:44 14 BY MS. DOAN:

01:46:44 15 Q. Mr. Godici, could you please introduce yourself to

01:46:49 16 Judge Gilstrap?

01:46:49 17 A. Yes. My name is Nicholas Godici.

01:46:51 18 Q. And have you previously worked for the Patent and

01:46:53 19 Trademark Office?

01:46:53 20 A. Yes, I did. I worked for the Patent and Trademark

01:46:55 21 Office for 33 years.

01:46:56 22 Q. Are you the former Commissioner of Patents?

01:46:59 23 A. Yes, I am.

01:46:59 24 Q. Can you tell us a little bit about yourself, please,

01:47:02 25 sir?

01:47:02 1 A. Sure. I started at the Patent Office 1972. That ages  
01:47:08 2 me, I guess. And I started out as a patent examiner,  
01:47:11 3 worked my way up through the ranks as an assistant patent  
01:47:17 4 examiner, primary patent examiner, first line supervisor,  
01:47:21 5 up through the chain of -- of management at the Patent  
01:47:24 6 Office. And I was appointed the Commissioner For Patents  
01:47:27 7 in the year 2000.

01:47:28 8 Q. That same year, did you also serve as the Acting  
01:47:32 9 Undersecretary of Commerce?

01:47:33 10 A. I did. I did. There was the transition between the  
01:47:38 11 Clinton and Bush Administration. I was the career official  
01:47:42 12 at the Patent Office that was left in charge for about a  
01:47:45 13 year until the new undersecretary was nominated by the  
01:47:49 14 President and -- and confirmed by the Senate.

01:47:52 15 Q. And how long did you serve as the Commissioner of  
01:47:54 16 Patents, sir?

01:47:55 17 A. I was Commissioner for Patents for five years, from  
01:47:59 18 2000 to 2005.

01:48:00 19 Q. And did you prepare an expert report in this case?

01:48:03 20 A. I did, yes.

01:48:04 21 Q. What materials have you reviewed in this case, sir?

01:48:07 22 A. Well, I reviewed the -- the file history, obviously, of  
01:48:11 23 the -- of the patent-in-suit, of the '049, of the -- of the  
01:48:13 24 '756. I reviewed the provisional application. I reviewed  
01:48:17 25 the deposition testimony of the two inventors, Dr. Zhu,

01:48:23 1 Dr. Li. And I reviewed the deposition testimony of the  
01:48:30 2 attorney that prosecuted the application, Mr. Tankha. And  
01:48:34 3 whatever other documents that I may have cited in my expert  
01:48:37 4 report.

01:48:38 5 Q. Did you also review -- were you here for the entire  
01:48:41 6 trial, sir?

01:48:42 7 A. Yes, I was.

01:48:42 8 Q. And did you hear the testimony of Dr. Stern?

01:48:45 9 A. I -- I did, yes.

01:48:46 10 Q. And had you previously spoken to him about the -- his  
01:48:50 11 opinions before you prepared your expert report?

01:48:52 12 A. Yes. As I recall, we spoke more than once on the  
01:48:56 13 telephone. And we were preparing expert reports that were  
01:49:00 14 due, I believe, on the same day. So I didn't have a chance  
01:49:04 15 to review his final report, but we spoke about his reports,  
01:49:07 16 yes.

01:49:07 17 Q. All right. Now, I want to talk a little bit about the  
01:49:11 18 duty of candor. And I know that Judge Gilstrap is very  
01:49:14 19 familiar with the duty of candor and the duty of  
01:49:17 20 disclosure. So I want to focus this conversation on how it  
01:49:20 21 applies to this particular claim that we have for  
01:49:23 22 inequitable conduct against Dr. Li, Dr. Zhu, and Ashok  
01:49:27 23 Tankha. Okay?

01:49:27 24 A. Okay.

01:49:28 25 Q. All right. So, tell us, on the duty of candor and duty

01:49:32 1 of disclosure, does it apply to information that you may  
01:49:36 2 have but failed to disclose?

01:49:38 3 A. Exactly. That's the -- that's the point of the -- of  
01:49:41 4 the duty of disclosure. The applicants and the applicant's  
01:49:45 5 representative are obligated to disclose to the Patent  
01:49:50 6 Office information that they know is material to the  
01:49:53 7 patentability of the claims of the patent application under  
01:49:56 8 review.

01:49:57 9 Q. Even if that material cuts against the patentholder?

01:50:01 10 A. Sure. I mean, that -- that's the whole concept here.  
01:50:03 11 The idea is you give us everything. The -- the most  
01:50:06 12 important is the most important.

01:50:08 13 So you give us that information so that the Patent  
01:50:12 14 Office and the patent examiner has the most relevant and  
01:50:15 15 material information before they make the final decision on  
01:50:18 16 whether or not to issue the patent.

01:50:19 17 So that -- you know, that's kind of the bargain.  
01:50:22 18 This -- you know, the Patent Office is issuing a patent  
01:50:25 19 that's valuable. It's a 20-year -- 20-year protection on  
01:50:29 20 the invention.

01:50:30 21 But, in exchange, the -- the applicant has the  
01:50:33 22 obligation to tell the Patent Office about all the  
01:50:35 23 information that's relevant and material to the examination  
01:50:39 24 process.

01:50:39 25 Q. If the -- if the patent attorney -- the prosecuting



01:50:43 1 attorney or the patent applicant has information in their  
01:50:46 2 possession that they know discloses a certain element of  
01:50:50 3 the claim and yet argues to the Patent Office that that  
01:50:55 4 element is not shown in the prior art, would that be a  
01:50:57 5 violation of the duty of candor?

01:51:00 6 A. Absolutely. That -- that's very important to the  
01:51:02 7 office. If you know about information relative to a  
01:51:05 8 particular limitation of the claim, yes.

01:51:07 9 Q. With respect to false statements or making false  
01:51:12 10 declarations to the Patent Office, would that also be a  
01:51:16 11 violation of the duty of candor?

01:51:20 12 A. Sure. If -- if you make a -- a false statement or a  
01:51:21 13 declaration to the Patent Office -- and by declaration I  
01:51:23 14 assume it's under the penalty of perjury -- if -- if that's  
01:51:27 15 a false statement, then there are consequences. And  
01:51:30 16 that -- that would have to be disclosed to the Patent  
01:51:32 17 Office that you made a false statement. You shouldn't make  
01:51:34 18 false statements. You can't make false statements.

01:51:37 19 Q. What is the consequence of violating the duty of  
01:51:40 20 candor?

01:51:40 21 A. Well, if you violate the duty of candor, and there's --  
01:51:43 22 there's the possibility of the finding of inequitable  
01:51:45 23 conduct if there's intent to deceive. If there's a finding  
01:51:52 24 of inequitable conduct, a patent can be held unenforceable,  
01:51:55 25 the entire patent, all of the claims in the patent are held

01:52:00 1 unenforceable.

01:52:00 2 Q. What is the difference between the violation of a duty  
01:52:04 3 of candor and inequitable conduct?

01:52:04 4 A. Well, inequitable conduct, you have to -- you have to  
01:52:06 5 show two things. You have to show that the information  
01:52:09 6 that was not submitted to the Patent Office was material.

01:52:13 7 I understand it's the "but for" materiality test,  
01:52:17 8 and you have to show and prove that there was intent to  
01:52:20 9 deceive the Patent Office by not submitting that material  
01:52:22 10 information.

01:52:27 11 Q. Okay. So here under 37 CFR 1.56, Section B,  
01:52:34 12 Subsection 2, I think we've talked about this. If it  
01:52:35 13 refutes or is inconsistent with the position that applicant  
01:52:37 14 takes in argument to the Patent Office for asserting an  
01:52:40 15 argument of patentability, that would be a violation of the  
01:52:43 16 duty of candor?

01:52:43 17 A. Exactly. You can't -- you can't take a position and --  
01:52:48 18 and state that such and such is -- is information that's --  
01:52:52 19 that carries patentable weight but not disclose the fact  
01:52:56 20 that you might have information that that was prior art,  
01:52:58 21 yes.

01:52:59 22 Q. And, here, the duty of candor and the obligation to be  
01:53:05 23 candid with the Patent Office is owed by not only Dr. Li  
01:53:09 24 and Dr. Zhu but also by their patent attorney --  
01:53:12 25 prosecuting attorney, Ashok Tankha?

01:53:16 1 A. Yes.

01:53:16 2 THE COURT: Just a moment.

01:53:17 3 MR. FABRICANT: I realize it's a trial to the  
01:53:19 4 bench, however, these are very leading questions,  
01:53:23 5 Your Honor, to an expert witness.

01:53:24 6 THE COURT: Well, it is before the Court. I  
01:53:31 7 certainly don't want counsel effectively testifying, but  
01:53:35 8 I'm going to allow both sides some latitude beyond what I  
01:53:40 9 would if this were before a jury, for no other reason than  
01:53:43 10 to move the process forward.

01:53:44 11 MR. FABRICANT: Thank you.

01:53:45 12 THE COURT: Please proceed, Ms. Doan.

01:53:47 13 MS. DOAN: Thank you, Your Honor.

01:53:49 14 Q. (By Ms. Doan) With respect to the opinion of the  
01:53:50 15 intent to deceive for a finding of inequitable conduct, who  
01:53:55 16 makes that finding?

01:53:56 17 A. Well, in this case, Judge Gilstrap will make that  
01:54:00 18 decision. That's not up to the expert to -- to -- to reach  
01:54:04 19 the ultimate conclusion of whether or not there's  
01:54:07 20 inequitable conduct. This is -- this is the Judge's  
01:54:09 21 decision to make.

01:54:10 22 Q. Should you give an opinion?

01:54:11 23 A. I have an opinion, but I -- I understand that I have  
01:54:17 24 not given an opinion, and I don't believe that it's the  
01:54:20 25 expert's position to -- to make an opinion on the ultimate

01:54:25 1 conclusion of whether or not there's inequitable conduct.

01:54:27 2 Q. So why are you here today?

01:54:29 3 A. Well, I'm here to -- to walk through some of the facts  
01:54:32 4 that are relevant to making that final decision that  
01:54:38 5 Judge Gilstrap will have to make, by explaining the  
01:54:40 6 prosecution history and what was and wasn't disclosed to  
01:54:43 7 the Patent Office.

01:54:43 8 Q. Have you broken your testimony up into four sections  
01:54:47 9 for the Court today?

01:54:48 10 A. I have, yes. And you'll see the four here on these  
01:54:52 11 bullets.

01:54:52 12 Q. And the first one is the relationship and the  
01:54:55 13 prosecution history of the '756 and the '049 patents?

01:54:57 14 A. Exactly. I wanted to just lay out that there are three  
01:54:59 15 applications in this sequence and explain them.

01:55:02 16 Q. Okay. And the second point is the failure to disclose  
01:55:05 17 the Li article in both the '756 and the '049 patents?

01:55:07 18 A. Exactly. That -- the last three are the allegations of  
01:55:10 19 inequitable conduct that I'd like to talk about and lay out  
01:55:14 20 facts relative to those allegations.

01:55:17 21 It's the failure to disclose the Li article, it's  
01:55:19 22 the failure to disclose the Brandstein book, and it's also  
01:55:21 23 the -- the fact that there were declarations in the  
01:55:25 24 reissue, the '049 -- that resulted in the '049 patent that  
01:55:29 25 were false declarations.

01:55:29 1 Q. Now, in the trial itself, we talked about some false  
01:55:34 2 declarations with respect to the '623 patent application.  
01:55:39 3 Is this the same false declarations you're talking about  
01:55:42 4 here today, sir?

01:55:42 5 A. No, these are -- these are declarations that were filed  
01:55:46 6 in the '049 patent, and ultimately resulted in the issuance  
01:55:51 7 of the '049 patent.

01:55:53 8 Q. All right. Let's start with the first bullet there,  
01:55:55 9 the relationship to the '756 and the '049. Have you  
01:55:58 10 prepared some slides for us to go through here today?

01:56:01 11 A. Yes.

01:56:01 12 Q. All right. So on the provisional application, which I  
01:56:03 13 believe is DTX-15 --

01:56:05 14 THE COURT: Ms. Doan, you know what I'm going to  
01:56:07 15 do. I'm going to ask you to slow down.

01:56:10 16 MS. DOAN: Yes, sir. Yes, Your Honor. I will  
01:56:12 17 slow down.

01:56:13 18 THE COURT: Please.

01:56:15 19 Q. (By Ms. Doan) With respect to the provisional  
01:56:16 20 application, DTX-15, we heard yesterday that that  
01:56:19 21 application is not reviewed by the Patent Office and with  
01:56:24 22 respect to -- I'm looking at the '756 patent application or  
01:56:27 23 the '049 reissued patent application; is that right?

01:56:32 24 A. Yes. I don't know if I got that entire question. So  
01:56:35 25 maybe you can repeat it.

01:56:38 1 But what we're seeing here is the provisional  
01:56:40 2 application, which is the first in the sequence of these  
01:56:42 3 three applications that was filed, and then it's been  
01:56:45 4 referred to as the real application or the -- or the real  
01:56:48 5 patent application. The Patent Office would call it the  
01:56:51 6 non-provisional patent application. But it's the -- it's  
01:56:54 7 the patent application that is then examined and can mature  
01:56:58 8 to a -- to a patent.

01:57:00 9 Q. Okay. So I want to make sure that I've got that right.  
01:57:03 10 With respect to the provisional application, DTX-15, that  
01:57:05 11 was filed on September 24th, 2010, is that provisional  
01:57:12 12 application part of the file wrapper of the '756 patent or  
01:57:15 13 the '049 patent?

01:57:16 14 A. No, it's not part of the file wrapper. And I'm not  
01:57:20 15 sure -- you know, in the old days, we actually had file  
01:57:24 16 wrappers. We had the paper copy. But now it's more  
01:57:28 17 electronic. But they have different serial numbers, they  
01:57:31 18 have different identification.

01:57:32 19 So when the examiner is forwarded the -- the  
01:57:35 20 application, for example, the non-provisional or the real  
01:57:38 21 application to examine, the -- the provisional application  
01:57:41 22 is not embedded inside of that. It's a separate document  
01:57:44 23 that's -- that's -- that's in the -- that's in the archives  
01:57:48 24 of the Patent Office database.

01:57:51 25 Q. Do you know whether the provisional application,

01:57:54 1 DTX-15, was reviewed by the patent examiner who examined  
01:57:58 2 the '756 patent application?

01:58:01 3 A. Well, there was no indication that it was reviewed, no.  
01:58:04 4 And -- and, normally, a provisional application would not  
01:58:08 5 be reviewed by the patent examiner.

01:58:11 6 The only time that you would actually look at the  
01:58:14 7 provisional application is if -- is when there is a  
01:58:17 8 question of whether or not the effective filing date of the  
01:58:19 9 provisional application is important. And you only look at  
01:58:23 10 that if there's an intervening prior art reference.

01:58:26 11 In this case, all the prior art that was disclosed  
01:58:31 12 by the applicants or found by the Patent Office was well  
01:58:35 13 before the provisional date. So there was no question  
01:58:37 14 about whether or not it was prior art.

01:58:39 15 So, based on my experience, the examiner would  
01:58:41 16 have no reason to -- to review the provisional application  
01:58:45 17 when examining the -- the '756.

01:58:48 18 Q. In your review of the provisional application, DTX-15,  
01:58:53 19 was there an information disclosure statement, or an IDS,  
01:58:58 20 that was filed with the provisional application?

01:59:01 21 A. No, there was no IDS that was filed in the provisional  
01:59:06 22 application, no.

01:59:06 23 Q. So even if a reference is cited and is listed in the  
01:59:10 24 provisional application, was -- from your review of the  
01:59:13 25 file, was there any type of references or prior art

01:59:18 1 submitted with the provisional application?

01:59:20 2 A. No, there's no I -- you don't file an IDS with a  
01:59:26 3 provisional application.

01:59:26 4 Q. So, with respect to the '756 patent, which is PTX-2,  
01:59:31 5 we've heard testimony in the trial that that has been a  
01:59:35 6 surrendered patent?

01:59:37 7 A. Yes, by virtue of the fact that the reissue application  
01:59:41 8 that followed it issued, yes.

01:59:43 9 Q. Can the '756 patent, the surrendered patent, still be  
01:59:47 10 subject to inequitable conduct?

01:59:48 11 A. Yes. It could be found that -- that it was obtained  
01:59:52 12 through inequitable conduct, and if that's the case, it  
01:59:58 13 could be found that that patent should never have issued.

02:00:01 14 And if that's the case, then the '049 wouldn't exist. You  
02:00:05 15 wouldn't be able to reissue a patent that shouldn't have  
02:00:08 16 been issued in the first place.

02:00:10 17 Q. So, if inequitable conduct is found with respect to the  
02:00:12 18 application of the '756 patent, then that could affect  
02:00:17 19 every other patent that it's related to?

02:00:20 20 A. It can affect the downstream, the later -- the later  
02:00:24 21 patents and patent application, it can infect them. In  
02:00:30 22 other words, the act that occurred, if it's found to be  
02:00:32 23 inequitable conduct in the '756, can infect the downstream  
02:00:36 24 patents, obviously because they wouldn't be there or they  
02:00:40 25 wouldn't exist, or at least exist in that form, had the --



02:00:44 1 had the information that was not given to the Patent Office  
02:00:47 2 and not considered by the Patent Office in the underlying  
02:00:53 3 '756, you know, if that was given and there was a  
02:00:55 4 rejection, there would have either been an abandonment or a  
02:00:58 5 substantial change in that patent.

02:01:00 6 Q. Have the opinions that -- or the opinions and your  
02:01:03 7 review of the '756 patent and the '049 patent in this case,  
02:01:08 8 have you considered the facts with respect to the duty of  
02:01:12 9 candor and the facts that support or don't support  
02:01:14 10 inequitable conduct with respect to both patents?

02:01:16 11 A. I'm not sure I got that. Could --

02:01:20 12 Q. Sure, I'm so sorry --

02:01:22 13 A. Could --

02:01:26 14 Q. Yes. From your opinions in your expert report, do they  
02:01:31 15 just rely upon the '756 patent, or do you give opinions  
02:01:34 16 with respect to the '756 patent and the '049 patent?

02:01:35 17 A. Both, both patents.

02:01:36 18 Q. All right. Let's look at the '756 patent.

02:01:38 19 We'll just -- the prosecution history of the '756  
02:01:43 20 patent is DTX-55. Have you reviewed the entire file  
02:01:48 21 history for the '756 patent application?

02:01:50 22 A. Yes, yes, I have.

02:01:51 23 Q. And what are we looking at here, DDX-8.8?

02:01:55 24 A. This is simply, at the time of the filing of the '756  
02:01:59 25 application, there was an IDS submitted by the applicants

02:02:03 1 or the applicants' representative, Mr. Tankha, and these  
02:02:09 2 are the -- these are the five references that were  
02:02:10 3 submitted to the Patent Office to be reviewed when they  
02:02:14 4 examined the '756 application.

02:02:15 5 Q. Okay. So I've got a board over here with the  
02:02:18 6 prosecution of the '756 patent. Can you see that, sir?

02:02:20 7 A. Yes, I can see it.

02:02:24 8 Q. And would the information disclosure statement, or the  
02:02:29 9 IDS, be submitted with the patent application itself?

02:02:33 10 A. It was in this case, yes.

02:02:35 11 Q. All right. And then you see there's five references?

02:02:37 12 A. Yes.

02:02:37 13 Q. Were there multiple information disclosure statements  
02:02:40 14 submitted with respect to the prosecution of the '756  
02:02:42 15 patent application?

02:02:43 16 A. No, there was only one. This is it. These are the  
02:02:46 17 only references that were submitted by the applicant to the  
02:02:49 18 Patent Office.

02:02:49 19 Q. Were there additional information disclosure statements  
02:02:53 20 submitted with respect to the '049 application?

02:02:55 21 A. No, there weren't. There weren't any. So, obviously,  
02:02:58 22 in examination of the '049, they had these five references  
02:03:02 23 that were in the '756, but there were no additional  
02:03:04 24 references submitted at any point in time.

02:03:06 25 Q. And that's listed in DTX-55.84; is that right, sir?

02:03:11 1 A. What's listed, excuse me?

02:03:13 2 Q. That's okay. The information disclosure statement that  
02:03:15 3 we're looking at in front of you on the screen, can that be  
02:03:18 4 found in DTX-55.84?

02:03:20 5 A. Yes.

02:03:22 6 Q. So after the patent was applied for, there was an  
02:03:27 7 Office Action; is that right?

02:03:28 8 A. Yes.

02:03:28 9 Q. All right. And what happened in that Office Action?

02:03:30 10 A. The Patent Office rejected all the claims of the  
02:03:33 11 original '756 application on prior art. As I recall, there  
02:03:38 12 was an obviousness rejection of those claims based on two  
02:03:41 13 references, Kim and Chol reference.

02:03:46 14 Q. And then what happened?

02:03:47 15 A. Then the applicant responded. And this is -- this,  
02:03:50 16 what we're seeing here, is the amendment that was submitted  
02:03:52 17 by Mr. Tankha to the Patent Office after the rejection of  
02:03:58 18 the -- the initial rejection of the claims.

02:04:00 19 Q. And in his applicant's response, did he amend Claim 1  
02:04:05 20 of the '756 patent?

02:04:07 21 A. He amended Claim 1 and Claim 11. So, in other words,  
02:04:10 22 the two independent claims in the application were amended.  
02:04:12 23 And you can see what's in yellow and highlighted here is  
02:04:15 24 the additional information -- or additional limitation that  
02:04:22 25 was added to both of those claims. And it's the limitation

02:04:25 1 that we've been calling the "determining a delay"  
02:04:28 2 limitation, sometimes referred to as Limitation [C]. But  
02:04:32 3 it's the limitation determining a delay, and you can see  
02:04:35 4 that limitation right here.

02:04:37 5 Q. All right. So this applicant's response appears to be  
02:04:40 6 filed May 9th of 2014; is that right?

02:04:43 7 A. Yes.

02:04:44 8 Q. And it's found at DTX-55.145 through 146?

02:04:48 9 A. Yes.

02:04:48 10 Q. Now, we heard testimony from Dr. Li that he gave the Li  
02:04:56 11 article to his lawyer in 2013, just then. Did you hear  
02:05:00 12 that testimony?

02:05:01 13 A. Yes.

02:05:04 14 Q. If Mr. Tankha had the Li article which disclosed  
02:05:08 15 determining -- determining a delay, and that information  
02:05:10 16 was material, would that be considered in determining  
02:05:16 17 whether inequitable conduct was held here or whether the  
02:05:19 18 duty of candor was breached?

02:05:19 19 A. Yes, it would. Yes.

02:05:21 20 Q. All right. Let's look at the applicant's response.  
02:05:28 21 This is by Mr. Tankha, as well?

02:05:30 22 A. Right. So this goes with the amendment that we just  
02:05:32 23 saw. So, in other words, Mr. Tankha amends the claim and  
02:05:38 24 adds the determining a delay feature to the claim, that  
02:05:42 25 limitation. And then this is the argument that he -- that

02:05:44 1 he submits to the Patent Office in relation to that  
02:05:48 2 amendment.

02:05:50 3 And -- and what he's saying is that the prior  
02:05:52 4 art -- in this case, the prior art that was used to reject  
02:05:54 5 one of the references was Chol, as I mentioned. He's  
02:05:58 6 saying that the prior art does not show this determining  
02:06:02 7 the delay limitation, and, therefore, the Patent Office  
02:06:06 8 should allow this claim.

02:06:10 9 Q. So, if the only issue with respect to -- he -- if the  
02:06:14 10 patent prosecutor has the determining a delay limitation  
02:06:17 11 with him in an article and then argues to the Patent Office  
02:06:21 12 that it's not shown in the prior art, would that be  
02:06:24 13 something for Judge Gilstrap to consider in determining  
02:06:30 14 inequitable conduct?

02:06:30 15 A. Absolutely. I mean, if -- if you're making an argument  
02:06:34 16 that this is the patentable feature and you're actually --  
02:06:39 17 and saying that's it's not shown in the prior art but you  
02:06:40 18 have information that it is part of the prior art, you must  
02:06:44 19 tell the Patent Office about that. And that is information  
02:06:46 20 that -- that should and could be considered by  
02:06:50 21 Judge Gilstrap.

02:06:51 22 Q. In the patent applicant's response that was filed in  
02:06:54 23 May of 2014, was a subsequent IDS prepared or filed at that  
02:07:00 24 time?

02:07:00 25 A. No. My recollection there were no other IDSs. There

02:07:04 1 were -- no other references were submitted to the Patent  
02:07:07 2 Office.

02:07:07 3 Q. All right. And then what happened?

02:07:09 4 A. Well, then the examiner allowed the '756 application.  
02:07:13 5 And when an examiner allows an application, there's  
02:07:16 6 normally what's called a reasons for allowance.

02:07:19 7 So this is -- to make the record clear, to make  
02:07:22 8 the prosecution history clear, the examiner states the  
02:07:25 9 reason they're allowing -- he -- he or she is allowing the  
02:07:29 10 application.

02:07:30 11 And what you see here in yellow is the reason.  
02:07:32 12 And the examiner says: Neither Kim nor Chol teaches the  
02:07:37 13 method of improving sound quality by combining various  
02:07:42 14 units, such as the sound source localization unit, adaptive  
02:07:48 15 beamforming unit, and noise reduction unit, where in the  
02:07:51 16 arbitrary configuration of the microphone array is  
02:07:53 17 determined by the delays, predefined angle, reference axis,  
02:08:00 18 and azimuth angle, et cetera.

02:08:01 19 And -- and it's important -- the last sentence is  
02:08:03 20 also important: So it is agreed that the prior art of  
02:08:06 21 record does not teach the amended independent claims.

02:08:14 22 Well, the amended independent claim, the only  
02:08:17 23 amendment in it is that determining the delay limitation  
02:08:19 24 that we saw earlier when he filed the amendment.

02:08:22 25 Q. So, in sum, for the '756 patent prosecution, the claims

02:08:25 1 were rejected. And then there's a determining a delay  
02:08:34 2 amendment. And then the Patent Office allowed the patent  
02:08:37 3 to issue based upon the amendment of determining a delay.  
02:08:39 4 Is that right?

02:08:39 5 A. That's right. That's about as clear as it gets in  
02:08:42 6 terms of tracking exactly the rationale and reasons and  
02:08:45 7 arguments of -- of patentability.

02:08:47 8 In other words, the amendment went in, there's an  
02:08:50 9 argument that this carries the weight for patentability,  
02:08:53 10 the examiner agrees, and issues the patent.

02:08:58 11 Q. All right. Now, you're aware here, sir, that Amazon is  
02:09:01 12 alleging that Vocalife committed inequitable conduct before  
02:09:04 13 the Patent Office, correct?

02:09:05 14 A. I'm aware of that, yes.

02:09:06 15 Q. All right. And we're alleging that, specifically with  
02:09:09 16 respect to Manli Zhu, Dr. Peter Li, and Ashok Tankha, the  
02:09:14 17 patent prosecutor?

02:09:16 18 A. Correct, correct, they all had the duty of candor, duty  
02:09:20 19 of disclosure.

02:09:21 20 Q. And did you find three -- what are the grounds that  
02:09:22 21 Amazon alleges establish inequitable conduct during the  
02:09:26 22 prosecution of the '756 patent and the '049 patent?

02:09:28 23 A. Well, the allegations are -- the grounds are, number  
02:09:32 24 one, the Li article that -- that has been discussed  
02:09:36 25 extensively, that was never submitted to the Patent Office.

02:09:38 1 That wasn't submitted in -- in either the '756 or the '049.

02:09:41 2 Q. Let's talk about that next.

02:09:42 3 A. Okay.

02:09:43 4 Q. So the '756 patent issues. Are you -- are you

02:09:49 5 familiar, sir, with DTX-14, the Li article?

02:09:51 6 A. Yes. I've seen it, yes.

02:09:53 7 Q. And you know that we've been discussing this 2009 Li

02:09:58 8 article all week?

02:09:59 9 A. Yes.

02:09:59 10 Q. Remind us what Dr. Manli Zhu said about the Li article

02:10:03 11 disclosing the determining a delay statement.

02:10:05 12 A. This is from her trial testimony a few days ago. I was

02:10:10 13 here to witness it.

02:10:11 14 But she said -- so the question was: So -- and to

02:10:18 15 be clear, you describe linear microphone arrays, as well as

02:10:22 16 circular microphone arrays, in the '049 patent, right,

02:10:25 17 Dr. Zhu?

02:10:25 18 And she said: Yes, they are two special cases for

02:10:30 19 my invention.

02:10:31 20 And then it went on to -- to the question -- the

02:10:35 21 next question is: So for the case of linear microphone

02:10:39 22 array, you show the same formula for calculating the delay

02:10:42 23 in your 2009 article -- that's the Li article -- as you do

02:10:47 24 in Figure 6B from your '049 patent, don't you, Dr. Zhu?

02:10:52 25 And she said: Yes.



02:10:53 1 Q. And you're aware that the '049 patent covers not only  
02:10:57 2 the circular array, that I think we tried in the trial this  
02:11:00 3 week, but also the linear array?

02:11:03 4 A. Correct. The -- the patent is broad enough to -- to  
02:11:06 5 incorporate or to encompass both linear and circular  
02:11:10 6 arrays.

02:11:10 7 Q. If the patent examiner had an article which disclosed  
02:11:15 8 the formula for determining a delay in a linear array,  
02:11:21 9 should it also have been -- should that have been given to  
02:11:23 10 the Patent Office in determining the patentability of the  
02:11:27 11 '756 and the '049 patents?

02:11:29 12 A. Sure. The -- the linear array is -- is -- is equally  
02:11:33 13 as important as the circular array, because the -- the  
02:11:36 14 claim -- the applicants claimed both types of arrays.

02:11:40 15 So if you have information with respect to the  
02:11:41 16 linear array that the determining the delay calculation was  
02:11:46 17 known, then that's important information.

02:11:48 18 Q. And you were in court the day that we covered --

02:11:54 19 MS. DOAN: I think this is not advancing. Can you  
02:11:59 20 advance for me, please, Mr. Berk?

02:12:01 21 Q. (By Ms. Doan) Yes. The relationship of the '756 and  
02:12:04 22 '049, the Li article disclosed a certain formula for  
02:12:08 23 determining a delay. Are you familiar with that?

02:12:09 24 A. Yes.

02:12:10 25 Q. And you're familiar -- do you see also when Dr. Zhu was

02:12:13 1 questioned about this same formula, was -- was specifically  
02:12:17 2 disclosed in the '756 patent and the '049 reissue?

02:12:20 3 A. Yes. And -- and as highlighted here, my understanding  
02:12:25 4 is that in the 180-degree configuration, which would be the  
02:12:31 5 linear configuration, the -- the formulas are the same.

02:12:36 6 Q. And are you -- are you giving an opinion about  
02:12:41 7 materiality of the Li article here today?

02:12:43 8 A. No, I'm not the technical expert on materiality.  
02:12:48 9 I'm -- I'm laying out the -- what I've seen as the evidence  
02:12:51 10 by others with respect to materiality.

02:12:53 11 Q. And are you relying upon the testimony of Dr. Stern?

02:12:57 12 A. Yes.

02:12:57 13 Q. And what did Dr. Stern say during this trial, sir?

02:13:01 14 A. Well, he -- he talked about the Li article, and he  
02:13:04 15 says: Which reference has already been discussed in this  
02:13:07 16 trial -- this is a question -- showing all the limitations  
02:13:10 17 of this -- of this claim -- of Limitation [C]?

02:13:14 18 In other words, remember, Limitation [C] is what's  
02:13:19 19 sometimes referred to as determining a delay limitation.

02:13:21 20 He says: Well, among others, we heard on Friday,  
02:13:26 21 I believe from Dr. Soo -- quite possibly from Dr. Li --  
02:13:30 22 that paper that Dr. Li presented at the ICASSP -- the  
02:13:34 23 I-C-A-S-S-P Conference in 2009 in Taiwan -- Taiwan, which  
02:13:38 24 is shown up here on the screen, disclosed the same method  
02:13:41 25 of determining the delay that was cited in the '049 patent.

02:13:45 1 Q. In your discussions with Dr. Stern before you submitted  
02:13:48 2 your expert report, did he give you an opinion with respect  
02:13:51 3 to materiality?

02:13:52 4 A. Yes.

02:13:53 5 Q. And what was that?

02:13:53 6 A. Oh, he -- he told me that -- that the Li article  
02:13:59 7 disclosed the determining the delay feature that was in the  
02:14:04 8 '049 patent claims.

02:14:04 9 Q. Now, you -- in your review of the file history, the Li  
02:14:08 10 article was not submitted in the '756 or the '049 patent,  
02:14:11 11 the file histories, right?

02:14:13 12 A. It was not submitted, no.

02:14:14 13 Q. After we file -- after the Plaintiff filed this  
02:14:20 14 lawsuit, Vocalife, you're aware that we made a claim for  
02:14:22 15 inequitable conduct, right?

02:14:24 16 A. Correct.

02:14:24 17 Q. And in the '623 patent application file, are you aware  
02:14:29 18 as to whether the Li article was -- was submitted in that  
02:14:32 19 file by Vocalife?

02:14:34 20 A. It was. So just to explain, the '623 patent was  
02:14:42 21 referred to in trial as the second reissue patent  
02:14:45 22 application. And after this litigation started,  
02:14:48 23 sometimes -- sometime at the beginning of this calendar  
02:14:51 24 year, the Li article was submitted in that second reissue  
02:14:54 25 application.

02:14:55 1 Q. And what happened?

02:14:58 2 A. The Patent Office used the Li article to reject the  
02:15:00 3 claims in that particular application.

02:15:02 4 Q. So would that also be an indication of materiality, as  
02:15:07 5 well?

02:15:07 6 A. It could be, yes. I mean, obviously, the - there's --  
02:15:11 7 there's slight -- there's differences to the claims. But  
02:15:14 8 if you look at what the Patent Office said with respect to  
02:15:16 9 what's taught in the Li article, my review of the file  
02:15:20 10 history looked -- looked as if they're -- they're stating  
02:15:23 11 that it teaches the determining the delay feature.

02:15:25 12 Q. And the '623 file history could be found at Exhibit  
02:15:30 13 No. 980, I believe; is that right?

02:15:35 14 A. I'm sure you're correct, but I don't know that.

02:15:37 15 Q. All right. Ultimately, did -- were those claims  
02:15:41 16 allowed in the '623 patent?

02:15:42 17 A. The '623 patent application was just recently allowed,  
02:15:46 18 within the last month or two, I think, yes.

02:15:48 19 Q. And how could that patent be allowed if, indeed, the Li  
02:15:54 20 article is but-for material?

02:15:55 21 A. Well, number one, as I said, the claims -- the claims  
02:16:01 22 were different. Obviously, you're -- you're not going to  
02:16:03 23 have the same claims in a -- in a second reissue as you  
02:16:06 24 have in the first reissue, so there -- there are different  
02:16:06 25 limitations in those claims.

02:16:09 1 And the second thing, I did review the reasons for  
02:16:12 2 allowance that the Patent Office stated recently in -- in  
02:16:15 3 the '623. And they -- and they stated that there were --  
02:16:19 4 and also the arguments that were made by the applicant.  
02:16:21 5 And they're arguing different elements that -- that were  
02:16:24 6 patentable.

02:16:28 7 So, in other words, they didn't argue that --  
02:16:30 8 that -- that -- Li article didn't show the determining the  
02:16:33 9 delay limitation, but argued -- and that's [C] -- they  
02:16:40 10 argued that the Li article didn't show, for example, [D] or  
02:16:45 11 [E] or [F] limitation in the claim, so they argued  
02:16:48 12 different limitations for patentability.

02:16:48 13 Q. So the second reissue issued based on other elements of  
02:16:52 14 the claim?

02:16:52 15 A. It's allowed. I'm not sure it's issued yet, but it's  
02:16:55 16 allowed based on other elements. Arguments that other  
02:16:59 17 elements carry the weight for patentability.

02:17:00 18 Q. Now, we've heard testimony in trial that obviously  
02:17:04 19 Dr. Li and Dr. Zhu knew about the article they wrote in  
02:17:08 20 2009.

02:17:08 21 Have you also had an opportunity to read the  
02:17:11 22 deposition testimony of Ashok Tankha, the prosecuting  
02:17:14 23 attorney?

02:17:14 24 A. Yes, I have.

02:17:15 25 Q. And did he also admit that he had the Li article during

02:17:18 1 the prosecution of the '756 patent?

02:17:21 2 A. Yes, it's my understanding that he had the Li article,  
02:17:24 3 yes.

02:17:25 4 Q. All right. So I think this line of questioning is  
02:17:27 5 about the '049 patent. But we've heard through Mr. --  
02:17:32 6 through Dr. Li that he gave him -- sorry -- that Dr. Li  
02:17:37 7 gave Mr. Tankha a copy of the Li article in 2013, right?

02:17:42 8 A. Yes.

02:17:45 9 Q. And now I'm looking at Slide DD -- DDX-8.18, which is  
02:17:49 10 the testimony from Ashok Tankha. And does he sit here and  
02:17:52 11 disclose also if he had it in the '049 filed patent while  
02:17:57 12 it was being -- the '049 patent was also being applied for?

02:18:00 13 A. Yes, he had the Li article. Yes, he had -- when the  
02:18:04 14 '049 was being prosecuted, yes.

02:18:06 15 Q. And he admitted that he did not give the Li article to  
02:18:09 16 the Patent Office with respect to the prosecution of the  
02:18:16 17 '049 filed patent, did he?

02:18:18 18 A. That's right, he admitted that he did not give it to  
02:18:20 19 the Patent Office.

02:18:21 20 Q. And he admits that, there at the bottom, that he did  
02:18:23 21 not give it, even though the 2009 conference paper  
02:18:26 22 discloses a formula for determining a delay. Right?

02:18:28 23 A. Yeah. If you look at the line of questioning, that's  
02:18:31 24 exactly what happened. He's first -- he's first asked,  
02:18:35 25 does the paper -- in other words, in the Office Action

02:18:38 1 response you relied on -- so he amended the claim, and he's  
02:18:41 2 telling -- he's answering that he relied on that  
02:18:44 3 determining a delay feature at -- to carry the weight for  
02:18:49 4 patentability.

02:18:50 5 And he says: Yes.

02:18:53 6 And then he says you -- and he's asked: You  
02:18:55 7 didn't disclose the conference paper to the patent  
02:18:57 8 examiner?

02:18:58 9 And he says: No, not in this particular  
02:19:00 10 application.

02:19:01 11 And he says: You had a copy of it?

02:19:03 12 He says: Yes, I had a copy of it.

02:19:05 13 And he says -- and then he's asked: Even though  
02:19:06 14 the 2009 conference paper discloses a formula for  
02:19:10 15 determining a delay, right, you still didn't submit it to  
02:19:13 16 the Patent Office?

02:19:15 17 And he says: Yes.

02:19:18 18 MS. DOAN: Your Honor, at this time we have  
02:19:20 19 deposition testimony from Ashok Tankha to be submitted with  
02:19:24 20 this record. Would you like me to submit it by exhibit or  
02:19:29 21 just receive the deposition testimony?

02:19:29 22 THE COURT: I think you ought to designate it as  
02:19:32 23 an exhibit and submit it that way.

02:19:34 24 MS. DOAN: We'll do that, Your Honor. We also  
02:19:36 25 have deposition testimony -- testimony of Manli Zhu, in

02:19:38 1 addition to her trial testimony.

02:19:39 2 THE COURT: Then submit it in the same way.

02:19:43 3 MS. DOAN: Thank you, Your Honor.

02:19:44 4 Q. (By Ms. Doan) All right. So, Mr. Godici, with respect  
02:19:46 5 to the finding of intent to deceive with respect to the  
02:19:50 6 withholding of the Li article in the '756 and the '049  
02:19:53 7 patent application, what type of facts would be relevant to  
02:19:57 8 Judge Gilstrap's determination of whether the applicants,  
02:20:01 9 Dr. Li or Dr. Zhu or Mr. Tankha, had an intent to deceive  
02:20:06 10 the Patent Office by withholding the Patent Office -- by  
02:20:09 11 withholding the Li article? Apologies.

02:20:11 12 A. Well, I prepared a list of those, and we can -- we can  
02:20:14 13 run down through that list that will appear on this slide.

02:20:18 14 But, first of all, both the inventors and  
02:20:22 15 Mr. Tankha knew that Claim 1 was amended to include that  
02:20:25 16 determining a delay limitation. And we've talked about  
02:20:27 17 that.

02:20:27 18 So that was the amendment to supposedly carry the  
02:20:30 19 patentability of the '756 application.

02:20:38 20 Q. And is that what Dr. Li was just testifying about that  
02:20:40 21 he made sure that his lawyers gave him all the filings from  
02:20:44 22 the Patent Office and correspondence?

02:20:45 23 A. Exactly. He was questioned by -- by Mr. Re, and he  
02:20:49 24 said that -- he said that certain previous attorneys were  
02:20:57 25 not doing that for him, so he wanted to make sure he had an



02:21:01 1 attorney that would keep him up-to-date and give him that  
02:21:05 2 information.

02:21:05 3 Q. And that was the privilege log that Mr. Re covered with  
02:21:08 4 Dr. Li with respect to the certain entries where they were  
02:21:11 5 indeed shown to be transmitted to Dr. Li?

02:21:11 6 A. That's my understanding, yes.

02:21:13 7 Q. All right. What's the second basis, sir?

02:21:16 8 A. Well, just basically did they know about the -- the  
02:21:20 9 reasons for allowance that the examiner put in the Office  
02:21:23 10 Action. In other words, not only did they know that the  
02:21:25 11 amendment was submitted, but they also know that the  
02:21:27 12 examiner accepted that amendment, accepted the arguments,  
02:21:30 13 and stated this is the reason we're allowing that patent  
02:21:33 14 application.

02:21:33 15 Q. And another -- another -- another fact to consider?

02:21:38 16 A. Obviously, they knew of the article. They were the  
02:21:41 17 authors of the article, the Li article.

02:21:42 18 Q. And that's DTX-14?

02:21:46 19 A. And then the question is, whether they knew that it  
02:21:49 20 included the determining a delay limitation. And then  
02:21:53 21 we -- we saw that Dr. Zhu had testified that it does,  
02:21:57 22 especially when -- when it's in a linear array rather than  
02:22:01 23 a circular array.

02:22:03 24 So they were aware and -- and -- and Tankha, their  
02:22:09 25 attorney, Mr. Tankha, was also aware that -- in his

02:22:12 1 testimony, he stated that the determining a delay  
02:22:14 2 limitation was in the Li article.

02:22:17 3 Q. And --

02:22:18 4 A. The formulas.

02:22:19 5 Q. And you reviewed Manli Zhu's deposition testimony  
02:22:21 6 before you heard her testify in trial, right?

02:22:25 7 A. Yeah, she testified before trial, yes.

02:22:27 8 Q. Has her testimony always been consistent with respect  
02:22:30 9 to she knew the Li article disclosed the determining a  
02:22:34 10 delay step that was disclosed in the '756 and the '049  
02:22:38 11 patents?

02:22:38 12 A. I believe her testimony is consistent, yes.

02:22:41 13 Q. All right. Then the next -- the next item you would  
02:22:44 14 consider?

02:22:45 15 A. Well, again, we've heard the testimony that -- that the  
02:22:48 16 Li article was -- was sent by Dr. Li to Mr. Tankha, and --  
02:22:55 17 and we saw the letter or the email -- that -- redacted  
02:22:58 18 email that -- that Mr. Re disclosed today. So, yes, I see  
02:23:02 19 that information.

02:23:03 20 Q. Is there another basis, sir?

02:23:06 21 A. Well, we -- again, Mr. Li was questioned about the  
02:23:12 22 declarations that are required by -- by the Patent Office,  
02:23:16 23 all applicants that file for a patent application.

02:23:19 24 And so both inventors, Dr. Li and Dr. Zhu, signed  
02:23:26 25 those declarations indicating and acknowledging that they

02:23:29 1 knew about the duty of disclosure to the Patent Office in  
02:23:35 2 the prosecution of their patent application.

02:23:36 3 Q. All right. Then, finally, did Mr. Tankha have a duty  
02:23:39 4 to disclose the material prior art in the prosecution of  
02:23:43 5 the '756 and the '049 patents?

02:23:44 6 A. Yes, he did. Remember, Rule 56 requires both the  
02:23:48 7 applicants and the attorney prosecuting, they both -- they  
02:23:52 8 all have the -- the duty -- the candor and duty of  
02:23:55 9 disclosure.

02:23:55 10 Q. And from what you have reviewed, that would also  
02:23:58 11 include the Li article, material prior art?

02:24:00 12 A. Yes.

02:24:01 13 Q. All right. Now, let's set aside the failure to  
02:24:03 14 disclose the Li article, and let's look at the failure to  
02:24:06 15 disclose the Brandstein book with respect to the  
02:24:08 16 prosecution of the '756 and '049 patents, okay?

02:24:11 17 A. Okay.

02:24:11 18 Q. All right. We've talked about the Brandstein book all  
02:24:14 19 week. I believe it's DTX-49?

02:24:16 20 A. Correct.

02:24:16 21 Q. All right. And what did Dr. Stern tell us about the  
02:24:20 22 Brandstein book and what it disclosed with respect to the  
02:24:22 23 various elements?

02:24:24 24 A. Well, when Dr. Stern was -- was testifying, I remember  
02:24:26 25 that there was this -- this demonstrative up on -- up on

02:24:30 1 the board. And as -- as Mr. Re went through the various  
02:24:34 2 limitations of the claim of the '049, he checked them off  
02:24:39 3 with green checks in terms of -- of Dr. Stern's testimony  
02:24:43 4 that they were -- they were obvious or taught by, included  
02:24:47 5 in the Brandstein book.

02:24:49 6 THE COURT: I don't mean to interrupt, but I  
02:24:51 7 remember Dr. Stern's testimony thoroughly. There's no need  
02:24:54 8 to go through it again. If you want to pick out a specific  
02:24:57 9 point that you think is probative, please do that.

02:24:59 10 MS. DOAN: We'll do that, Your Honor.

02:25:01 11 Q. (By Ms. Doan) With respect to -- did he say that  
02:25:04 12 determining a delay was disclosed in the Brandstein book?

02:25:06 13 A. Yes.

02:25:06 14 Q. In addition, the Plaintiff's expert, Mr. McAlexander,  
02:25:11 15 did he also admit that the Brandstein book describes a  
02:25:16 16 determining a delay, Step [C], in Claim 1?

02:25:18 17 A. Yes, he did. You can see the simple question and  
02:25:22 18 answer here.

02:25:22 19 Q. Now, the '049 patent also had the DSP article -- DSP  
02:25:28 20 limitation, as well, added; do you remember that?

02:25:33 21 A. Correct. That was one of the additions that -- that  
02:25:37 22 were amended into the '049 patent application, yes.

02:25:40 23 Q. And did Dr. Stern give an opinion with respect to  
02:25:43 24 whether the Brandstein book taught the -- the sound source  
02:25:50 25 localization unit, the adaptive beamforming unit, and the

02:25:52 1 noise reduction unit were integrated into the digital  
02:25:55 2 signal processor?

02:25:55 3 A. Yes, he did. And he stated that the Brandstein book  
02:25:58 4 does disclose that.

02:25:59 5 Q. And did he show us where in the Brandstein book that  
02:26:03 6 was specifically disclosed?

02:26:04 7 A. Yes, he did. And we see the highlights here, and we  
02:26:07 8 see the -- the excerpt from the Brandstein book that he  
02:26:12 9 relied on to indicate that the DSP are incorporating  
02:26:16 10 those -- those elements on to the DSP would -- would be  
02:26:19 11 known or obvious.

02:26:21 12 Q. And they can be found at DTX-49.0392; is that right?

02:26:27 13 A. Yes.

02:26:28 14 THE COURT: Just a minute, Mr. Dacus, you need to  
02:26:31 15 have a mask on, sir.

02:26:33 16 MR. DACUS: My apologies to the Court, Your Honor.

02:26:35 17 THE COURT: No problem.

02:26:37 18 Please continue.

02:26:38 19 Q. (By Ms. Doan) And we know that Dr. Li and Dr. Zhu knew  
02:26:41 20 about Brandstein, Mr. Godici, because they referenced  
02:26:45 21 Godici at the end of the Li article, the 2009 Li article;  
02:26:50 22 is that right?

02:26:50 23 A. They referenced Brandstein, not Godici.

02:26:52 24 Q. Oh, I'm sorry. Did I misspeak? I'm so sorry.

02:26:55 25 A. Yes. As -- as we've heard several times now, the Li

02:27:00 1 article listed several references, documents. And one of  
02:27:04 2 them was the Brandstein book, yes.

02:27:06 3 Q. All right. Now, in your report, you show how the  
02:27:13 4 Brandstein textbook -- you go through pages and pages of  
02:27:17 5 how the textbook is incorporated into the 2010 provisional  
02:27:21 6 application; is that right?

02:27:22 7 A. Right. In my report, I line up a chart or a table, and  
02:27:25 8 we show the wording, the actual wording that's in the  
02:27:30 9 Brandstein book, and then the similar, if not identical,  
02:27:32 10 wording that -- that's in the provisional application.

02:27:35 11 Q. So the Brandstein textbook would be -- since portions  
02:27:40 12 were copied from the Brandstein textbook into the 2010  
02:27:45 13 provisional application, would that indicate to you that it  
02:27:46 14 would be important to the provisional application?

02:27:51 15 A. Certainly it would be important to the provisional  
02:27:54 16 application if, in fact, features or portions of -- of --  
02:27:58 17 of the Brandstein book end up in the claims as part of the  
02:28:02 18 important information in the claims of the patent, yes.

02:28:04 19 Q. And then here's some more -- for the portions of the  
02:28:09 20 Brandstein book that were copied into the provisional  
02:28:11 21 application, and with respect to Page 70 -- Page 170 from  
02:28:16 22 the Brandstein textbook and Page 171 were copied over into  
02:28:21 23 Page 7 of the 2010 provisional application, do you see  
02:28:24 24 that?

02:28:25 25 A. Correct. I think -- I think the point I was making in

02:28:27 1 my expert report is they obviously had the Brandstein  
02:28:30 2 book -- or whoever wrote the provisional application had  
02:28:33 3 the Brandstein book as -- as a reference. I think that  
02:28:35 4 was -- has been established.

02:28:37 5 Q. And then you were in court yesterday when  
02:28:40 6 Mr. McAlexander said that he had -- he agreed that the  
02:28:45 7 Brandstein textbook was removed from the '756 patent  
02:28:54 8 application. Do you recall that?

02:28:55 9 A. I think I recall his -- his -- his testimony, yes.

02:28:58 10 MS. DOAN: Do you have that slide, Mr. Berk?

02:29:24 11 Q. (By Ms. Doan) Okay. Where Mr. McAlexander said -- is  
02:29:28 12 questioned -- and I believe it was by Mr. Hadden: And it's  
02:29:33 13 a fact the Brandstein book was not considered by the Patent  
02:29:35 14 Office when it allowed the '049 patent? Agree?

02:29:40 15 And he says: I agree.

02:29:42 16 A. Yes, I see that.

02:29:43 17 Q. And then he was also questioned: And it's a fact that  
02:29:44 18 when Dr. Li filed his real application, he removed any  
02:29:47 19 reference to the Brandstein book; isn't that correct?

02:29:49 20 And then Mr. McAlexander said: It was not present  
02:29:52 21 in the filed application.

02:29:54 22 Is that correct?

02:29:57 23 A. That's correct.

02:29:58 24 Q. All right. So what factors should Judge Gilstrap  
02:30:03 25 consider with respect to his finding -- what types of facts

02:30:05 1 should he consider with respect to determination of whether  
02:30:06 2 the applicants, Dr. Li and Dr. Zhu and Mr. Tankha, had an  
02:30:11 3 intent to deceive the Patent Office by withholding the  
02:30:15 4 Brandstein textbook?

02:30:15 5 A. Okay. I've prepared a -- a demonstrative here with  
02:30:21 6 bullets like I did with the Li article, but this one  
02:30:24 7 referencing the -- the Brandstein -- the Brandstein  
02:30:26 8 textbook.

02:30:27 9 And, clearly, the -- the -- Dr. Li and Dr. Zhu  
02:30:30 10 were aware of the Brandstein book. I mean, they had  
02:30:32 11 mentioned it in their article. So they -- they knew about  
02:30:35 12 the Brandstein book. We -- we know that.

02:30:39 13 Q. And they also -- they also listed it in their  
02:30:41 14 provisional application?

02:30:42 15 A. Yes, they did.

02:30:43 16 Q. But it was removed in the '756 -- the application for  
02:30:47 17 the '756 patent; is that correct?

02:30:49 18 A. Exactly. So the -- to -- to explain again, at the end  
02:30:52 19 of the provisional application, there was a list of  
02:30:54 20 references that were used or cited to, with respect to the  
02:30:58 21 provisional application, but when the non-provisional  
02:31:03 22 application, what we'll call the real application, was  
02:31:06 23 filed at the Patent Office, that listing didn't appear  
02:31:10 24 in -- in that application. So it -- it was removed.

02:31:13 25 Q. And we saw that it was not submitted on -- the



02:31:16 1 Brandstein book was not submitted on an IDS on either the  
02:31:20 2 '756 or the '049 patents, correct?

02:31:21 3 A. That's correct. It was -- it was not submitted during  
02:31:23 4 the prosecution in an IDS, no.

02:31:27 5 Q. And it's not listed on the face of either patent; is  
02:31:30 6 that right?

02:31:30 7 A. That's correct.

02:31:30 8 Q. All right. What's next -- what other facts?

02:31:34 9 A. Well, again, we just -- we just looked at the fact that  
02:31:37 10 there were portions of the Brandstein book that -- that  
02:31:39 11 appear to be similar, if not identical in -- in the  
02:31:42 12 provisional application.

02:31:50 13 The next bullet is -- is what we just talked about  
02:31:53 14 is terms of removing the reference to the Brandstein book  
02:31:55 15 when they actually filed the patent application that was  
02:31:58 16 examined by the -- by the Patent Office.

02:31:59 17 Q. All right. And did Drs. Li and Zhu also submit  
02:32:04 18 declarations acknowledging their duty to disclose material  
02:32:07 19 prior art in the prosecution of both the '756 and '049  
02:32:10 20 patents?

02:32:10 21 A. Sure. The declarations that -- that are required of  
02:32:13 22 all inventors include acknowledgement of the duty of  
02:32:16 23 disclosure. So they -- and they did sign those  
02:32:19 24 declarations.

02:32:20 25 Q. And then when Mr. Tankha had the duty of disclosure

02:32:25 1 already as a patent lawyer -- before the patent bar?

02:32:28 2 A. Yes.

02:32:28 3 Q. All right. If Judge Gilstrap found that there was a  
02:32:30 4 specific intent to deceive the Patent Office by not  
02:32:34 5 submitting the Li article or the Brandstein book during  
02:32:36 6 either the prosecution of the '756 or the '049 patents,  
02:32:40 7 would that be supported by the facts in this case?

02:32:43 8 A. I believe that it would be, yes.

02:32:45 9 Q. All right. I'm going to turn to your last issue you're  
02:32:48 10 speaking about today, the false declarations in the '049  
02:32:52 11 patent. Is that okay?

02:32:57 12 A. Yes.

02:33:02 13 MS. DOAN: Mr Heideman, can you help me with this  
02:33:07 14 board, please? Yes, you can just put it on top. That's  
02:33:11 15 fine.

02:33:11 16 Q. (By Ms. Doan) Now, the final subject -- the next  
02:33:14 17 allegation of inequitable conduct is for the false reissue  
02:33:17 18 declaration submitted to the Patent Office in the '049  
02:33:20 19 patent application, correct?

02:33:21 20 A. Yes.

02:33:23 21 Q. It's totally separate than the failure to submit the Li  
02:33:27 22 article and the Brandstein book, right?

02:33:28 23 A. Yes, this is a third allegation.

02:33:29 24 Q. Why is this important?

02:33:30 25 A. Well, the -- the declaration that's filed in a

02:33:33 1 reissue -- reissue application is -- is very important.  
02:33:36 2 The -- the -- there's very specific rules with respect to  
02:33:40 3 what has to be disclosed in the declaration of a reissue  
02:33:43 4 application.

02:33:44 5 A reissue application is to correct an error in  
02:33:48 6 the underlying original app -- patent. And so you have to  
02:33:53 7 delineate very specifically what that error was and how  
02:33:57 8 you're correcting it. And it has to be done in the  
02:34:01 9 declaration that's signed by the applicants.

02:34:03 10 So it -- there are very specific instructions and  
02:34:07 11 requirements for those reissue declarations.

02:34:13 12 Q. Okay. If inequitable conduct was committed in the '756  
02:34:19 13 patent, can it be cured by just filing a reissue patent?

02:34:23 14 A. No. No, it cannot.

02:34:24 15 Q. All right. So let's look at the filing of the '049  
02:34:29 16 application. Can you tell us what happened with respect to  
02:34:31 17 the declarations that were filed on the -- with the patent  
02:34:33 18 application on 10/14/16? Can you see that?

02:34:37 19 A. Yes, I can -- I can see it.

02:34:40 20 Yes, there was -- there was a reissue declaration  
02:34:42 21 that was filed with the application when it was filed.  
02:34:45 22 There are two pages. This is -- this is the first page.  
02:34:48 23 You can see it was -- it was submitted or -- or signed by  
02:34:54 24 Inventor -- Inventor Li. And there's the duty of -- of  
02:34:59 25 perjury here with respect to -- respect to this

02:35:03 1 declaration.

02:35:03 2 But the important part are there -- there are two  
02:35:06 3 blocks checked here. The first block is that by -- and  
02:35:12 4 this is -- this is delineating the reasons for filing the  
02:35:16 5 reissue application, what are the errors that are being  
02:35:18 6 corrected?

02:35:20 7 And the first one is: By reason of the patentee  
02:35:23 8 claiming more or less than he had a right to claim in the  
02:35:27 9 patent.

02:35:27 10 What that means to the patent examiner and the  
02:35:31 11 Patent Office is that the scope of that claim is either too  
02:35:34 12 narrow and I want to broaden it, or too broad and I have to  
02:35:37 13 narrow it because of prior art. So there's going to be a  
02:35:40 14 change in the scope of the claims, and that's a trigger to  
02:35:42 15 the -- the Patent Office to -- to be aware of that.

02:35:47 16 And then it's also possible to correct other  
02:35:49 17 errors that don't have to do with the scope of the claim.  
02:35:51 18 Q. With respect to -- you said it's -- it's here -- signed  
02:35:55 19 under the penalty of perjury. Why is that important for  
02:35:58 20 the inventors -- or the applicants to know that you're  
02:36:01 21 signing under the penalty of perjury?

02:36:04 22 A. Well, I -- I guess it's just to explain how important  
02:36:07 23 it is to -- to be truthful and honest with the Patent  
02:36:11 24 Office when you're -- when you're, you know, submitting  
02:36:12 25 this declaration.

02:36:13 1 Q. All right. And you also see that there -- on the next  
02:36:18 2 page, it appears to be actually signed by Qi Li, which is  
02:36:22 3 Peter Li; is that right?

02:36:23 4 A. Correct, yes.

02:36:25 5 Q. And above that there's a reissue Application  
02:36:28 6 Declaration By The Assignee. Do you see that?

02:36:33 7 A. Yeah, the -- this is actually part of the -- the first  
02:36:33 8 page and I think the second page of that same declaration.

02:36:34 9 And you can see that -- that clearly, that there's  
02:36:36 10 a statement here: This is a broadening reissue.

02:36:38 11 So this lines up with the checking of that block  
02:36:41 12 that -- that stated that one of the errors is that the  
02:36:46 13 applicant is -- is correcting, is that was -- that the  
02:36:48 14 subject matter was more or less than -- than -- than what  
02:36:51 15 he was entitled to.

02:36:53 16 And it indicates that if the -- if you look at the  
02:36:57 17 sentence above: If the reissue is a broadening reissue, a  
02:37:01 18 claim that the applicant seeks to broaden must be  
02:37:05 19 identified and the box must be checked.

02:37:07 20 So there's an indication -- and that's the form.  
02:37:11 21 There's an indication that you have to tell us if you're  
02:37:13 22 broadening a claim -- you have to tell us you're broadening  
02:37:17 23 the claim, you have to tell us which claim you're  
02:37:21 24 broadening -- us, meaning the Patent Office -- and --  
02:37:26 25 and -- and explain that clearly to the patent examiner.

02:37:28 1 Q. So with respect to this direction, the box was checked,  
02:37:30 2 right --

02:37:30 3 A. Yes.

02:37:30 4 Q. -- as before? But was there a specific claim that was  
02:37:32 5 identified?

02:37:32 6 A. No, there wasn't. So, obviously, the -- the -- well,  
02:37:35 7 not obviously, but I'll explain, that the Patent Office  
02:37:38 8 rejected this declaration -- rejected the claims under the  
02:37:42 9 statute, 251, the reissue statute, rejected the claims for  
02:37:48 10 the reason that this was an improper reissued declaration  
02:37:52 11 because it didn't specify which claim was being -- being  
02:37:55 12 broadened and how it was being broadened.

02:37:57 13 Q. Okay. And, just for the record, the '049 patent file  
02:38:01 14 history is DTX-54, and we're on Page DTX-54.40.

02:38:07 15 A. Okay.

02:38:08 16 Q. All right. And this is also signed by Dr. Manli Zhu.  
02:38:11 17 Do you see that?

02:38:12 18 A. Yes.

02:38:13 19 Q. Also on October 14th, 2016?

02:38:15 20 A. Right.

02:38:15 21 Q. On Page DTX-54.42.

02:38:18 22 All right. What happened after the -- at the -- I  
02:38:20 23 think you were skipping ahead a second ago. But what  
02:38:24 24 happened after the application was applied for?

02:38:25 25 A. Well, after the application was applied for, the patent

02:38:29 1 examiner rejected the claims -- as I said before, rejected  
02:38:33 2 the claims under the -- the reissue statute, 251,  
02:38:38 3 improper -- or improper declaration. Also rejected the  
02:38:42 4 claims on prior art.

02:38:45 5 Q. Okay.

02:38:45 6 A. There was -- there was a -- a rejection of the claims  
02:38:47 7 based on 35 U.S.C. 103. And some references were applied  
02:38:52 8 in the claims of -- at that point in time, the Patent  
02:38:56 9 Office took the position that the claims were obvious.

02:38:58 10 Q. Okay. So with respect to the declarations, I want to  
02:39:01 11 focus on -- with respect to this first Office Action, and  
02:39:04 12 that would have been on October 5th, 2017.

02:39:08 13 We're on now DDX-8.36.

02:39:12 14 What did the Patent Office say?

02:39:13 15 A. Well, as you can see, the Patent Office said that the  
02:39:17 16 examiner notes that the reissue declaration recites the  
02:39:20 17 following reasons: The reissue is a broadening reissue.

02:39:24 18 The examiner determines that the statement does  
02:39:26 19 not identify the specific claim or claims. And the  
02:39:31 20 specific language -- therein lies the error.

02:39:34 21 In other words, again, the -- the Patent Office is  
02:39:36 22 saying, tell me the claim and tell me the specific language  
02:39:40 23 that's broadened here.

02:39:43 24 Q. And that's at 54 -- DTX-54.115 and 116. Do you see  
02:39:51 25 that -- page numbers?

02:39:52 1 A. Yes, I see that.

02:39:59 2 Q. And I ask that because -- do you have a notebook in  
02:40:02 3 front of you, Mr. Godici?

02:40:03 4 A. Yes.

02:40:04 5 Q. If you'll turn to DTX-54.115.

02:40:10 6 MS. DOAN: Mr. Berk, if you could pull this page  
02:40:13 7 up, DTX-54 -- 54.115?

02:40:21 8 Q. (By Ms. Doan) Above the issue -- above the Reissue  
02:40:25 9 Declaration at the very bottom of that page --

02:40:27 10 MS. DOAN: Two paragraphs up, Mr. Berk, please.

02:40:31 11 Q. (By Ms. Doan) This applicant is further reminded?

02:40:33 12 A. Yes. Oh, I'm sorry.

02:40:34 13 Q. Do you see where I am: The applicant is further  
02:40:36 14 reminded of the continuing obligation under 37 CFR 1.56 to  
02:40:42 15 timely apprise the office of any information which is  
02:40:45 16 material to patentability of the claims under consideration  
02:40:48 17 in this reissue application?

02:40:49 18 Do you see that?

02:40:50 19 A. Yes.

02:40:50 20 Q. At any time in the '049 was either the Li article or  
02:40:56 21 the Brandstein article submitted?

02:40:59 22 A. No.

02:41:00 23 Q. All right. Now let's turn to --

02:41:00 24 THE COURT: Let me interrupt for just a minute.

02:41:02 25 Let's go off the record.



02:41:05 1 (Off-the-record discussion.)

02:41:35 2 THE COURT: All right. Let's go back on the  
02:41:37 3 record.

02:41:41 4 Q. (By Ms. Doan) All right. So that was in the first  
02:41:43 5 Office Action, and then did the applicant make a response?

02:41:45 6 A. Yes.

02:41:46 7 MS. DOAN: If you could advance this, please,  
02:41:48 8 Mr. Berk.

02:41:49 9 Q. (By Ms. Doan) And the response came on January 29th,  
02:41:55 10 2018; is that right?

02:41:57 11 A. Yes.

02:41:57 12 Q. And it's found in DTX-54.271?

02:42:01 13 Can you tell us what the applicant's response was?

02:42:03 14 A. Well, the applicants responded by submitting a new  
02:42:11 15 reissue declaration. And this is -- this is a -- this is  
02:42:13 16 the renew issue -- or the second reissue declaration that  
02:42:18 17 was submitted by the applicants.

02:42:19 18 Q. And, again, he's signing -- Dr. Li and Dr. Zhu are  
02:42:23 19 signing under the penalty of perjury; is that right?

02:42:25 20 A. Yes.

02:42:26 21 Q. And are they, again, saying -- checking both boxes that  
02:42:29 22 they are applying for the reissue by reason of the patentee  
02:42:33 23 claiming more or less than they had a right to claim in the  
02:42:37 24 patent and by reason of other errors?

02:42:39 25 A. Yes, the same two blocks were checked in the original

02:42:43 1 declaration.

02:42:43 2 Q. And the next page here of the same form where it says  
02:42:47 3 that the actual claim must be identified that is broadened  
02:42:52 4 and the box below had to be checked; is that right?

02:42:54 5 A. Yes, that's part of the form, yes.

02:42:56 6 Q. And there's Peter Li's signature again; do you see  
02:42:59 7 that?

02:42:59 8 A. Yes.

02:43:00 9 Q. Were any claims identified as being broadened here?

02:43:02 10 A. No. Again, there were no claims that were identified  
02:43:04 11 as being broadened.

02:43:05 12 Q. But there are certain claims here that deal with  
02:43:08 13 they're being amended for more clarity. So can you give us  
02:43:11 14 some explanation on that?

02:43:12 15 A. Exactly. The -- the changes that are -- that are  
02:43:17 16 described here are not for broadening the claim but for  
02:43:21 17 clarifying the claim. And that would be the -- the other  
02:43:25 18 reasons block that's on the first page, as opposed to more  
02:43:28 19 or less than -- than block.

02:43:30 20 So right now, what's being identified are -- are  
02:43:33 21 amendments, but not broadening amendments or broadening  
02:43:37 22 changes, but changes for clarity.

02:43:39 23 Q. And then after this went in, did the Patent Office --  
02:43:47 24 I'm sorry. I misspoke -- let me strike that.

02:43:50 25 With respect to the applicants' -- strike that.

02:43:54 1 With respect to the -- after that went in, did the  
02:43:57 2 Patent Office issue a final rejection?

02:43:59 3 A. Yes.

02:44:00 4 Q. Was the final rejection based on the prior art?

02:44:02 5 A. No. The prior art rejection that I mentioned earlier  
02:44:06 6 was actually withdrawn, in view of the arguments that --  
02:44:10 7 that the applicants made.

02:44:11 8 But the -- there was a final rejection, but it was  
02:44:13 9 only based on the reissue statute and the fact that the  
02:44:17 10 reissue declaration was improper.

02:44:19 11 Q. And is the Patent Office clear in their final rejection  
02:44:22 12 that the examiner finds the patent arguments persuasive and  
02:44:27 13 reviews -- will withdraw the rejections to the claims based  
02:44:30 14 on the prior art found in DTX-54.292?

02:44:35 15 A. Yes, that's the last sentence down there. The  
02:44:37 16 rejection that they're -- that the examiner is talking  
02:44:40 17 about is the prior art rejection, not the rejection on the  
02:44:42 18 reissue statute.

02:44:43 19 Q. And why does the rejection stand?

02:44:45 20 A. On the reissue? Because -- again, because there was a  
02:44:48 21 failure to identify a claim that was broadened and the  
02:44:53 22 specific language in the claim and how it was broadened.

02:44:56 23 Q. Okay. And we can find that at DTX-54.287 and  
02:45:04 24 DTX-54.288 of the file history?

02:45:05 25 A. Correct.

02:45:05 1 THE COURT: Let me ask you, Ms. Doan, it's pretty  
02:45:08 2 clear from the file history what has and what hasn't  
02:45:11 3 happened. And I've seen many, if not all, of these forms  
02:45:15 4 as a part of the jury trial or -- if not during the actual  
02:45:19 5 jury trial, during the pre-trial hearings.

02:45:22 6 How does this relate to the issue of intent?

02:45:26 7 MS. DOAN: About to get there. This is not --

02:45:28 8 THE COURT: Let's get there.

02:45:29 9 MS. DOAN: We'll get there. This is not the  
02:45:31 10 issue --

02:45:31 11 THE COURT: No, let's get there now.

02:45:32 12 MS. DOAN: I'll go right now. This was not raised  
02:45:35 13 at pre-trial, Your Honor. This is a different file  
02:45:39 14 application.

02:45:39 15 THE COURT: Well, I know all about the attempt to  
02:45:41 16 broaden the claims.

02:45:42 17 MS. DOAN: Okay. All right. So --

02:45:43 18 THE COURT: I want to know about intent.

02:45:45 19 MS. DOAN: Yes, Your Honor.

02:45:46 20 Q. (By Ms. Doan) After the final rejection, what did the  
02:45:50 21 patent applicant do?

02:45:50 22 A. Filed a third reissue declaration.

02:45:52 23 Q. Is that shown here in DTX-54.326?

02:45:56 24 A. Yes.

02:45:56 25 Q. And what happened here?

02:45:57 1 A. Well, it changed. The block that would have been  
02:45:59 2 checked if there was any broadening in the claims was not  
02:46:03 3 checked this time. And the explanation that we see here is  
02:46:05 4 that the independent claims were amended for clarity.

02:46:12 5 So there's no -- in this situation, what the  
02:46:15 6 applicant is telling the Patent Office is, I'm amending  
02:46:18 7 these claims for clarity only, and I -- I'm not amending  
02:46:22 8 these claims for reason of broadening the claims.

02:46:27 9 Q. Why is that significant here?

02:46:28 10 A. Well, the Patent Office had rejected the claims under  
02:46:33 11 the statute, the 251 statute, saying the reissue  
02:46:37 12 declaration was -- was incorrect. And -- and you haven't  
02:46:41 13 told us what you're -- if you're broadening -- if this is a  
02:46:46 14 broadening reissue like you told me, you know, tell me the  
02:46:50 15 claim and tell me the -- the portion of that claim that's  
02:46:54 16 broadened.

02:46:54 17 And after two times failing to do that, the third  
02:46:56 18 time the declaration came in changing the reason for  
02:47:00 19 reissue, changing it to just clarifying, as opposed to  
02:47:02 20 broadening.

02:47:03 21 Q. And then withdrew the signing the box on broadening?

02:47:08 22 A. The consequence -- in the next action, the consequence  
02:47:11 23 was that, yes, the -- the patent examiner then withdrew the  
02:47:15 24 rejection on the reissued statute and issued the patent.

02:47:19 25 Q. Did they file an Attached Sheet explaining what they

02:47:25 1 had done instead?

02:47:25 2 A. Yes, this was the Attached Sheet that would have went  
02:47:28 3 with the declaration.

02:47:29 4 Q. And did the Attached Sheet in any way say, hey, I'm  
02:47:30 5 unchecking this box, but I'm going to go ahead and broaden  
02:47:30 6 the claims anyway?

02:47:31 7 A. No, it did not.

02:47:32 8 Q. Did it give an indication to the Patent Office that  
02:47:35 9 indeed they were no longer broadening the claims?

02:47:38 10 A. No.

02:47:39 11 Q. And is it signed by not only Peter Li but also Manli  
02:47:44 12 Zhu and Ashok Tankha?

02:47:47 13 A. Yes.

02:47:51 14 Q. So what's the problem, then, if they just decided not  
02:47:54 15 to broaden the claims?

02:47:55 16 A. Well, according to their attorney, the claims were  
02:47:59 17 broadened. I mean, you can see this is deposition  
02:48:03 18 testimony by -- by Mr. Tankha. And he says -- and he's  
02:48:07 19 questioned: So it was your understanding that the claims  
02:48:10 20 of the '049 reissue patent were broadened from the claims  
02:48:13 21 in the '756 patent in at least one respect, right?

02:48:17 22 And he agreed.

02:48:18 23 Q. And when you -- in your review of Mr. Tankha's  
02:48:21 24 deposition testimony at the deposition transcript,  
02:48:24 25 Page 154, does he specifically list certain claims that

02:48:28 1 were broadened with respect to the -- the reissue? I

02:48:33 2 believe it was Claim 32?

02:48:34 3 A. Yes, that's my recollection. He was asked was there at  
02:48:40 4 least one claim or what claims were broadened, and he  
02:48:42 5 identified Claim 32.

02:48:48 6 Q. So what you -- on your review, is this something --  
02:48:53 7 before I get to that. Is this something with respect to  
02:48:55 8 false declarations -- why -- is that something that  
02:48:56 9 Judge Gilstrap should consider in making his determination  
02:49:00 10 as to whether inequitable conduct has occurred here?

02:49:02 11 A. Exactly. But for the -- the filing of that last  
02:49:06 12 declaration that indicated -- or did not indicate there was  
02:49:09 13 broadening, but, in fact, Claim 32 was broadened, the  
02:49:13 14 reject -- the patent was issued.

02:49:15 15 In other words, with that explanation that there  
02:49:17 16 was no broadening, the patent was issued, and the rejection  
02:49:21 17 of the claims was -- was withdrawn based on that  
02:49:24 18 representation by the applicant.

02:49:27 19 THE COURT: And you believe that goes to  
02:49:29 20 materiality?

02:49:29 21 THE WITNESS: I believe that goes to materiality,  
02:49:32 22 because, yes, Your Honor, because the patent would not have  
02:49:35 23 issued.

02:49:36 24 THE COURT: Do you believe that goes to the issue  
02:49:39 25 of intent?

02:49:39 1 THE WITNESS: Well, I think that's your -- your --  
02:49:42 2 your call, yes. But it looks to me like he knew that  
02:49:46 3 the -- the reissued declaration -- or, excuse me, the  
02:49:52 4 changes in the reissue application broadened the claims.

02:49:55 5 He admitted that Claim 32 was broadened. It's  
02:49:58 6 clear that you have to identify -- if you are broadening  
02:50:01 7 any one claim in the patent, you have to identify that --  
02:50:04 8 by number that claim and how it was broadened. And he  
02:50:07 9 failed to do that.

02:50:08 10 And by failure to identify that broadening, the  
02:50:14 11 declaration that was submitted was accepted by the Patent  
02:50:17 12 Office, and the '049 patent was issued.

02:50:20 13 THE COURT: All right.

02:50:21 14 Q. (By Ms. Doan) Mr. Godici, in your opinion, was this  
02:50:23 15 declaration false, the final declaration that was filed?

02:50:27 16 A. Yes, because it failed to identify the claim that was  
02:50:30 17 broadened.

02:50:30 18 Q. And, indeed, the claims were broadened; is that right?

02:50:32 19 A. Yes.

02:50:33 20 Q. And Mr. Tankha knew that the claims were broadened,  
02:50:37 21 right?

02:50:37 22 A. Correct.

02:50:38 23 Q. Mr. Godici, there's three separate claims that you've  
02:50:44 24 dealt with here. Tell us, if you believe there's a pattern  
02:50:47 25 of inequitable conduct, why is that something that we



02:50:50 1 should consider here?

02:50:52 2 A. Well, Judge Gilstrap will -- will look at the facts,  
02:50:58 3 and there are three allegations of inequitable conduct that  
02:51:00 4 I've -- that I've -- point out facts relative to.

02:51:05 5 So the question is not just one instance that  
02:51:08 6 occurred, but during the prosecution of these applications,  
02:51:11 7 there's more than one instance that occurred. And so  
02:51:15 8 the -- you know, the -- the fact that there may be a  
02:51:18 9 pattern here is something to be considered by  
02:51:21 10 Judge Gilstrap.

02:51:22 11 Q. All right. And down here, you have other bases, as  
02:51:25 12 well.

02:51:25 13 Does your report just list the bases, the failure  
02:51:29 14 to disclose the Li article, the failure to disclose the  
02:51:32 15 Brandstein book, and the submission of the false reissue  
02:51:35 16 declarations in the '049 patent?

02:51:37 17 A. Those are the only bases that I identified in my  
02:51:40 18 report, yes.

02:51:40 19 Q. And you are aware that there are other bases that we  
02:51:43 20 are raising here that have developed recently but they're  
02:51:47 21 not included in your report, is that right?

02:51:49 22 A. Correct.

02:51:53 23 MS. DOAN: Your Honor, I went through Mr. Godici's  
02:51:53 24 qualifications, but apparently I failed to offer him as an  
02:51:55 25 expert witness. We'd like to --

02:51:55 1 THE COURT: It's before the Court, I consider him  
02:51:57 2 an expert witness.

02:51:59 3 MS. DOAN: Thank you, Your Honor. Pass the  
02:51:59 4 witness.

02:51:59 5 THE COURT: Cross-examination.

02:52:30 6 Proceed when you're ready, Mr. Lambrianakos.

02:52:33 7 MR. LAMBRIANAKOS: Thank you very much,  
02:52:33 8 Your Honor.

02:52:33 9 CROSS-EXAMINATION

02:52:39 10 BY MR. LAMBRIANAKOS:

02:52:39 11 Q. Good afternoon, Mr. Godici.

02:52:41 12 A. Good afternoon.

02:52:42 13 Q. You're not here as a technical expert, correct?

02:52:48 14 A. That's correct, I am not.

02:52:49 15 Q. And you don't claim to have any technical expertise in  
02:52:52 16 the areas that are disclosed in the Li article or the  
02:52:54 17 Brandstein book, right?

02:52:56 18 A. That's correct.

02:52:56 19 Q. And you don't have any independent opinion regarding  
02:52:59 20 the scope of the delay technology that's disclosed in the  
02:53:05 21 Li article, right?

02:53:06 22 A. I'm not here to opine on the -- the scope of that  
02:53:10 23 particular limitation as a technical expert, no.

02:53:14 24 Q. All right. And that's -- that goes the same for the --  
02:53:17 25 the Brandstein book. You're not here to offer opinions

02:53:21 1 about what it discloses, right?

02:53:22 2 A. That's correct. I'm not up here to talk about the  
02:53:25 3 technical parts of the Brandstein book, but just to refer  
02:53:28 4 to others that have -- that have identified those portions,  
02:53:31 5 yes.

02:53:32 6 Q. You're not an attorney, right?

02:53:34 7 A. I am not.

02:53:36 8 Q. You don't offer opinions on claim construction,  
02:53:42 9 correct?

02:53:42 10 A. I do not.

02:53:43 11 Q. So you don't have any understanding of the scope of the  
02:53:48 12 claims of the '756 patent, right?

02:53:51 13 A. Well, I wouldn't say I don't have any understanding  
02:53:54 14 of the -- of the scope of the claims. I -- I -- you know,  
02:53:57 15 I worked at the Patent Office for many years. I understand  
02:54:00 16 how the Patent Office would look at those claims. But I'm  
02:54:04 17 not here to offer opinions, let's put it that way -- with  
02:54:07 18 respect to the scope of the claims.

02:54:08 19 Q. And the same goes for the '049 patent, right?

02:54:10 20 A. I -- I'm not here to offer opinions with respect to the  
02:54:13 21 scope of the claims of the '049 patent.

02:54:16 22 Q. You're familiar with the regulations of the Patent  
02:54:19 23 Office, right?

02:54:20 24 A. Yes.

02:54:21 25 Q. What is an incorporation by reference, to your

02:54:28 1 understanding?

02:54:29 2 A. An incorporation by reference is when you actually  
02:54:32 3 state that you're incorporating by reference some other  
02:54:37 4 information, and it has to be a specific statement that's  
02:54:43 5 made -- normally in the specification of an application,  
02:54:48 6 you will see incorporation by reference.

02:54:50 7 Q. And is the effective incorporation by reference that  
02:54:54 8 the document, which is incorporated by reference, is deemed  
02:54:57 9 to be in the document which incorporates by reference as if  
02:55:00 10 its entire contents were in the document incorporated?

02:55:04 11 A. I think I followed that. But, in general, yes. If you  
02:55:09 12 make -- if you make the specific statement the way the  
02:55:12 13 Patent Office recognizes that statement, it's possible that  
02:55:16 14 you can incorporate by reference, yes.

02:55:18 15 Q. So an application can incorporate another application  
02:55:21 16 by reference, correct?

02:55:22 17 A. It's possible, yes.

02:55:24 18 Q. And that document, which is incorporated, is deemed to  
02:55:28 19 be part of the content of the document that incorporates  
02:55:31 20 it, right?

02:55:31 21 A. If done properly, yes.

02:55:33 22 Q. Have you reviewed the application that issued as the  
02:55:40 23 '756 patent?

02:55:40 24 A. Yes.

02:55:42 25 Q. You've reviewed it in its entirety?

02:55:45 1 A. Yes.

02:55:46 2 Q. So you agree that the application, as filed for the  
02:55:50 3 '756 patent, incorporated the provisional application we  
02:55:53 4 have been discussing by reference, right?

02:55:55 5 A. No.

02:55:59 6 Q. Why do you disagree?

02:56:01 7 A. I -- I haven't seen any document or I haven't seen  
02:56:05 8 any -- any incorporation by reference of the provisional  
02:56:09 9 application to the -- that's -- appears in the '756.

02:56:59 10 MR. LAMBRIANAKOS: May I please have the ELMO?

02:57:02 11 Q. (By Mr. Lambrianakos) Sir --

02:57:11 12 MS. DOAN: Your Honor --

02:57:12 13 THE COURT: Yes, Ms. Doan.

02:57:13 14 MS. DOAN: I'd like to have the page reference  
02:57:17 15 before --

02:57:17 16 MR. LAMBRIANAKOS: I'm about to give you that.

02:57:19 17 MS. DOAN: Thank you, sir.

02:57:19 18 Q. (By Mr. Lambrianakos) I'm showing you a document that  
02:57:21 19 is part of PTX-4. The ending Bates number is 151.

02:57:33 20 Have you seen this before, sir?

02:57:34 21 A. I don't recall seeing it, no.

02:57:36 22 Q. Do you see the first paragraph says that the  
02:57:39 23 application claims benefit of the provisional Patent  
02:57:43 24 No. 61/403,952?

02:57:46 25 A. Yes.

02:57:46 1 Q. And is that the provisional application that we've been  
02:57:49 2 discussing?

02:57:51 3 A. I believe it is. I don't have the -- the serial number  
02:57:59 4 memorized, but I could identify it if I had the front page  
02:58:05 5 of the '756.

02:58:08 6 Q. Sir, is this the '756 patent?

02:58:25 7 A. Yes.

02:58:25 8 Q. Do you see under "related U.S. application data" in the  
02:58:30 9 left-hand column next to Item 60, it names the provisional  
02:58:35 10 application No. 61/403,952?

02:58:39 11 A. I see that, yes.

02:58:41 12 Q. And that's the same number that is referred to in the  
02:58:51 13 application for the '756 patent, right?

02:58:52 14 A. Yes. If this is the application for the '756, yes.

02:58:54 15 Q. Do you see the application number from the previous  
02:59:26 16 page in this application, 13/09877?

02:59:35 17 A. I see that's the application number identified in this  
02:59:37 18 paper, yes.

02:59:38 19 Q. And is that the application number for the '756 patent?

02:59:44 20 A. If you -- if you bring back the '756 patent -- yes, it  
02:59:47 21 is.

02:59:47 22 Q. So, after that, can we agree that the content of the  
03:00:00 23 specification of the provisional application ending in '952  
03:00:07 24 was incorporated by reference in its entirety into the '756  
03:00:12 25 patent application?

03:00:12 1 A. Well, that's the statement that's made here. They talk  
03:00:15 2 about the specification, and I -- and I assume what you're  
03:00:20 3 talking about is the -- the listing at the end of the  
03:00:25 4 application. And I don't know if that's considered part of  
03:00:28 5 the specification or not. I -- I wouldn't consider it.  
03:00:30 6 But I see what you're saying. I understand that.

03:00:32 7 Q. You wouldn't consider the references listed at the end  
03:00:36 8 of the specification of the provisional application to be  
03:00:38 9 part of the provisional application specification?

03:00:41 10 A. I -- I -- to be honest with you, I've never -- I've  
03:00:45 11 never been asked that question before. I don't know if I  
03:00:49 12 would or not. But the specification is normally just the  
03:00:53 13 description of the invention and not other parts of the  
03:00:55 14 application.

03:00:56 15 The other part of the situation here would be --  
03:01:00 16 if I may, Your Honor.

03:01:02 17 THE COURT: Go ahead.

03:01:04 18 A. The fact that -- we've talked about the fact that  
03:01:07 19 examiners wouldn't normally look at the provisional  
03:01:09 20 application because, in this case, there was no intervening  
03:01:12 21 prior art.

03:01:13 22 So whether or not it's incorporated or not, really  
03:01:16 23 wouldn't make a difference. The real question is, did the  
03:01:19 24 examiner go back and review it, and did the examiner know  
03:01:26 25 and -- and consider the Brandstein book that was listed in

03:01:30 1 the provisional? And, as I said before, there's no  
03:01:32 2 indication that the examiner did that.

03:01:34 3 THE COURT: So let me interrupt. Are you saying  
03:01:38 4 beyond the duty of candor and disclosure, there's a duty to  
03:01:43 5 ensure that the examiner sees what you disclose?

03:01:44 6 THE WITNESS: No.

03:01:45 7 THE COURT: Or do you just have a duty to disclose  
03:01:47 8 it, and then it's the examiner's responsibility to either  
03:01:49 9 consider it or not consider it once it's been disclosed?

03:01:53 10 THE WITNESS: The latter, Your Honor.

03:01:56 11 THE COURT: Okay. Mr. Rubin -- Mr. Rubino, if it  
03:02:00 12 will help you to stay up there, whatever moves this process  
03:02:03 13 along.

03:02:04 14 MR. RUBINO: Potentially, Your Honor.

03:02:05 15 THE COURT: There's a lot of paper up there. If  
03:02:07 16 you can assist your co-counsel, whatever -- in whatever way  
03:02:11 17 you can, maybe that will speed the process along.

03:02:23 18 Q. (By Mr. Lambrianakos) Do you recognize this page as  
03:02:25 19 the last page of the specification of the provisional  
03:02:27 20 application we've been discussing, DTX-15?

03:02:30 21 A. It's the last page of the application. I don't know if  
03:02:33 22 it's the specification or not. I mean, I'm not saying it  
03:02:36 23 is. I just -- you know, the format here in the -- in the  
03:02:40 24 provisional application is much different than the format  
03:02:43 25 of a -- of a normal application. But it is the last page



03:02:49 1 of that application, yes.

03:02:52 2 MR. LAMBRIANAKOS: Mr. Thompson, could you please  
03:02:54 3 put DTX-15 up on the screen? Would you please move to  
03:03:04 4 the -- DTX-15.28, the 28th page -- the prior page?

03:03:14 5 Q. (By Mr. Lambrianakos) So you see, sir, we're getting  
03:03:16 6 to the end of the specification in this application, right?

03:03:20 7 A. Well, that's the page before the ending, yes.

03:03:22 8 Q. Right. And then the next page comes?

03:03:26 9 A. Yes.

03:03:26 10 Q. And at the bottom of the last page of the  
03:03:28 11 specification, we see the Brandstein book reference, right?

03:03:31 12 A. I see that, yes.

03:03:34 13 Q. So do you -- do you -- would you agree, then, that this  
03:03:40 14 document, having been incorporated by reference, would  
03:03:43 15 include the entire specification, including the references  
03:03:47 16 to the Brandstein book?

03:03:50 17 A. Well, no. As I said before, the -- the real question  
03:03:53 18 is whether or not the Brandstein book was made available to  
03:03:57 19 the -- to the patent examiner and whether it was considered  
03:03:58 20 by the patent examiner at the Patent Office. Was it cited?  
03:04:04 21 And -- if you'll let me finish.

03:04:08 22 And -- and what I said before is that, even though  
03:04:10 23 the Brandstein book is -- is listed at the end of the  
03:04:15 24 provisional application, based on what I've seen, there's  
03:04:18 25 no indication that the patent examiner reviewed the

03:04:21 1 provisional application.

03:04:23 2           So whether it's incorporated by reference or not,  
03:04:26 3 unless he reviewed it and understood that the Brandstein  
03:04:30 4 book was important, it wasn't cited and it wasn't  
03:04:35 5 considered by the Patent Office.

03:04:37 6           So if you -- if you -- if you don't review the  
03:04:40 7 document that's supposedly incorporated by reference, then  
03:04:44 8 you haven't reviewed that document.

03:04:50 9 Q. Sir, is the -- was the Brandstein reference citation  
03:04:55 10 here incorporated by reference into the '756 patent  
03:04:59 11 application?

03:04:59 12 A. The specification of the -- of the -- of the  
03:05:02 13 provisional was, yes. I mean, I -- you can make an  
03:05:06 14 argument both ways whether or not this listing is part of  
03:05:09 15 the specification. That's the only distinction I'm trying  
03:05:12 16 to make.

03:05:12 17 Q. So it's possible that one might draw an imaginary line  
03:05:16 18 over the -- above where it says reference and only what's  
03:05:19 19 incorporated is above the imaginary line, and then what's  
03:05:23 20 below it is -- is not? Do you think that's a reasonable  
03:05:27 21 argument, sir?

03:05:28 22 A. Well, I -- I think -- I don't understand when they say  
03:05:31 23 incorporate the specification, because this specification  
03:05:34 24 is -- is unusual. That's all. It's not the normal format  
03:05:38 25 of a specification.

03:05:39 1 Q. Is it your opinion, sir, that if the applicant intended  
03:05:47 2 to deceive the Patent Office by hiding the Brandstein  
03:05:50 3 reference, that he would incorporate a document by  
03:05:54 4 reference into his application from the very beginning that  
03:05:57 5 cites specifically to the Brandstein reference?

03:05:59 6 A. Well, again, I'll -- I'll -- Judge Gilstrap will --  
03:06:03 7 will consider the intent prong here.

03:06:07 8 The other factor to be considered is, even though  
03:06:09 9 it's -- it's listed here in the provisional application, it  
03:06:13 10 was removed, and it was not listed when the -- when the  
03:06:16 11 actual application was filed.

03:06:18 12 So for some reason, it -- it was removed. That  
03:06:22 13 reference or -- or that listing was not put into the  
03:06:27 14 specification or was not listed in the application for the  
03:06:33 15 '756.

03:06:33 16 Q. But doesn't your answer assume that it's not already  
03:06:37 17 incorporated by reference and listed within the  
03:06:39 18 specification?

03:06:40 19 A. No, my answer is that it's not -- doesn't appear in the  
03:06:43 20 specification of the '756 application.

03:06:46 21 Q. But it is incorporated by reference, isn't it?

03:06:49 22 A. The -- the provisional specification is incorporated by  
03:06:53 23 reference, yes.

03:06:54 24 THE COURT: Let me ask you a question, Mr. Godici.

03:06:57 25 In a former life, I used to have a pretty robust

03:07:02 1 real estate practice. And in that area of the law, if  
03:07:05 2 there is an item in your chain of title, you're held to  
03:07:10 3 have constructive notice of everything in your chain of  
03:07:12 4 title. Whether you know it's there, whether you've seen  
03:07:16 5 it, whether you've considered it or not, if it's in that  
03:07:18 6 chain, you're charged with notice of it.

03:07:20 7 Is there anything similar or analogous to that  
03:07:25 8 that applies to the Patent Office, or is it only what the  
03:07:28 9 examiner actually has put before them and either they  
03:07:34 10 themselves or someone else causes them to actually focus on  
03:07:38 11 it?

03:07:39 12 THE WITNESS: That's a tough one to answer, sir.

03:07:43 13 But, yes, I think -- I think in some situations,  
03:07:46 14 yes. The -- the -- the question is whether or not  
03:07:50 15 information is in some way brought to the attention of the  
03:07:56 16 Patent Office.

03:07:56 17 THE COURT: I guess asked another way, is it the  
03:07:59 18 examiner's duty to scour the record, or is it the  
03:08:02 19 applicant's duty to not only disclose it but to ensure  
03:08:07 20 the -- the examiner sees what they have disclosed?

03:08:09 21 THE WITNESS: It's the examiner's duty to fully  
03:08:11 22 consider information that's submitted in -- in an  
03:08:14 23 information disclosure statement, where copies are  
03:08:18 24 submitted and so on and so forth.

03:08:20 25 It is possible to -- to -- to cite information --

03:08:26 1 for example, in the specification, you can mention a  
03:08:28 2 document or -- or a textbook or another patent, and so on  
03:08:35 3 and so forth, that the examiner will -- will consider.

03:08:39 4 All I can say is, when I looked at this patent  
03:08:43 5 application, the provisional and the non-provisional,  
03:08:47 6 granted the Brandstein book was cited as a reference at the  
03:08:51 7 bottom of the provisional application, there's no  
03:08:56 8 indication that the examiner actually looked at the  
03:08:58 9 provisional application, but that Brandstein book citation  
03:09:00 10 was not in the non-provisional application. Those are the  
03:09:04 11 facts that I can explain to you.

03:09:06 12 THE COURT: I'm aware. Okay. Let's move on,  
03:09:13 13 please.

03:09:13 14 Q. (By Mr. Lambrianakos) Regarding the Li article that  
03:09:17 15 you discussed --

03:09:18 16 A. Yes.

03:09:18 17 Q. -- what's your understanding about whether the Li  
03:09:22 18 article disclosed the '756 patent claim limitation of the  
03:09:29 19 sound source localization unit?

03:09:35 20 A. Well, again, I -- I didn't do an evaluation of the --  
03:09:39 21 of the technology. I'm not the technical expert. I relied  
03:09:43 22 on -- on others with respect to the technology.

03:09:48 23 What I talked about with respect to the Li article  
03:09:50 24 was the fact that the Li article and several folks  
03:09:54 25 testified that the Li article had that -- determining a

03:09:57 1 delay feature, and the importance of that was the fact that  
03:10:02 2 during the prosecution of the '756, the attorney, Tankha,  
03:10:06 3 put that delay feature into the claim, amended claim, in  
03:10:10 4 the Patent Office, and argued that that carried the weight  
03:10:15 5 of patentability. And the Patent Office agreed and allowed  
03:10:18 6 it.

03:10:18 7           So I talked about the determining a delay feature,  
03:10:25 8 but you're asking me about a different feature. And I  
03:10:28 9 didn't talk about that, and I haven't evaluated that.

03:10:31 10 Q. And you haven't evaluated whether the Li article  
03:10:35 11 discloses the adaptive beamformer of the claims of the '756  
03:10:38 12 patent, right?

03:10:38 13 A. Personally, I haven't evaluated it from a technology  
03:10:41 14 standpoint. I rely on the technical experts.

03:10:44 15 Q. So you don't have an opinion regarding whether the Li  
03:10:48 16 reference discloses all the limitations of the '756 patent?

03:10:52 17 A. I don't have an independent evaluation of that. That  
03:10:56 18 would be up to the -- the technical expert. I have to -- I  
03:10:59 19 would have to refer to their -- to their expertise.

03:11:02 20 Q. And you haven't been given any opinion regarding the  
03:11:05 21 claims of the '756 patent, right?

03:11:09 22 A. I disagree with that. Could you restate that question?

03:11:13 23 Q. You haven't been given any opinion from a technical  
03:11:17 24 expert regarding the scope of the claims of the '756  
03:11:19 25 patent, correct?

03:11:25 1 A. Well, certainly, there's been a lot of discussion from  
03:11:28 2 the technical experts about the limitations that are in the  
03:11:31 3 claims of the '049. To the extent that some are identical  
03:11:37 4 or substantially identical, then that would carry back to  
03:11:41 5 the '756. But I think to answer you specifically, what was  
03:11:45 6 treated at trial today was -- or over the last week was --  
03:11:50 7 were the claims of the '049.

03:11:51 8 Q. So you're not here to offer an opinion regarding  
03:12:05 9 whether the Li -- the Li article from 2009 was material to  
03:12:09 10 the scope of the patents -- the scope of the '756 patent  
03:12:12 11 application at the time it was filed, right?

03:12:18 12 A. No, I think the way I explained it now, and I hate to  
03:12:22 13 be repetitive, but the Li article discloses the determining  
03:12:27 14 a delay feature -- or limitation in the claims, and that's  
03:12:31 15 what carried weight and the patentability of the '756  
03:12:35 16 patent. That's why the Patent Office allowed that claim.

03:12:39 17 So, yes, the -- I -- I've stated that opinion that  
03:12:43 18 the Li article is -- does disclose that limitation, and  
03:12:45 19 that's relevant to the claims of the '756.

03:12:48 20 Q. The '756 patent disclosed determining a delay to enable  
03:12:52 21 beamforming in a plurality of arbitrary configurations,  
03:12:56 22 right?

03:12:56 23 A. Well, again, I'm not testifying with respect to the  
03:13:02 24 technology. We've all seen the phrase, the determining a  
03:13:07 25 delay limitation. I think, as someone said, it's a hundred

03:13:12 1 and some-odd words. So that's the limitation that -- that  
03:13:17 2 I'm talking about.

03:13:18 3 Q. Well, the examiner was looking at that limitation when  
03:13:21 4 he decided whether or not it was disclosed in the prior  
03:13:24 5 art, right?

03:13:26 6 A. Yes, the examiner would -- would -- would determine  
03:13:28 7 whether or not that limitation is disclosed, yes.

03:13:31 8 Q. And the materiality issue depends on understanding the  
03:13:35 9 scope of that claim term, determining a delay that enables  
03:13:40 10 beamforming for a plurality of arbitrary configurations,  
03:13:45 11 right?

03:13:45 12 A. Well, I think you just shortened it again. But, yes,  
03:13:49 13 the patent examiner would look at that limitation, all  
03:13:53 14 hundred and nine words or whatever, and then look to see  
03:13:56 15 whether that was part of the prior art or not.

03:13:58 16 Q. And you pointed to some testimony that was given by  
03:14:04 17 Manli Zhu about the determining a delay step?

03:14:08 18 A. (Nods head affirmatively.)

03:14:09 19 Q. Was she addressing the issue of whether her article  
03:14:13 20 disclosed the ability to determine a delay to enable  
03:14:18 21 beamforming in a plurality of arbitrary configurations?

03:14:20 22 A. My recollection is that she was describing determining  
03:14:24 23 a delay in a linear -- in -- in the situation where the --  
03:14:27 24 the microphones were linear. And that -- and as I said  
03:14:32 25 before, that's part -- that's within the -- that's within



03:14:36 1 the claim language. It could be linear, circular, or other  
03:14:40 2 configuration.

03:14:42 3 Q. Well, not in the '756 patent, though, is it?

03:14:45 4 A. The '756 says arbitrary, but it was corrected in the --  
03:14:50 5 in the '049 or clarified, let's put it, in the '049, yes.

03:14:55 6 Q. So as far as the '756 patent is concerned, there was no  
03:14:58 7 testimony regarding whether the Li article enables  
03:15:02 8 beamforming in a plurality of arbitrary configurations,  
03:15:06 9 right?

03:15:06 10 A. Well, unless you look at the term "arbitrary" to  
03:15:10 11 possibly include a straight line, yes. I mean, arbitrary  
03:15:14 12 is a very broad term, and may, in fact, again, not -- not  
03:15:19 13 determining the scope of the claim, but just for putting my  
03:15:21 14 patent examiner hat on, if it says arbitrary, it means that  
03:15:25 15 it could be most any kind of limit -- configuration and  
03:15:32 16 could be the straight line limitation or configuration.

03:15:35 17 Q. But that wasn't what Manli Zhu was referring to, right?  
03:15:39 18 She was referring to whether or not the -- the Li article  
03:15:44 19 in 2009 disclosed determining a delay with respect to a  
03:15:52 20 linear array, not an arbitrary configuration. Right?

03:15:54 21 A. Right. My understanding was she was looking at the  
03:15:57 22 language of the claim as it existed in the '049 patent,  
03:15:59 23 yes.

03:15:59 24 Q. Well, your slide, Slide 8.19?

03:16:17 25 MR. LAMBRIANAKOS: If we could put that up.

03:16:19 1 Q. (By Mr. Lambrianakos) That doesn't refer to claim  
03:16:20 2 language, right; that just talks about determining -- the  
03:16:23 3 determining a delay limitation in general?

03:16:25 4 A. Correct. But I -- you know, as we went through the --  
03:16:29 5 the earlier slides, we clearly identified what constituted  
03:16:34 6 the determining the delay limitation, that 109-word  
03:16:41 7 paragraph we see in the claims.

03:16:43 8 Q. In the claims of the '049 patent?

03:16:44 9 A. Well, it was incorporated -- it went into -- it went  
03:16:49 10 into the '756, and then it also appears in the '049.

03:16:52 11 Q. And it was amended, right, and reissued?

03:16:57 12 A. Yes, the claim was amended and reissued, yes.

03:17:00 13 Q. So the scope of the claim of the '756 patent, with  
03:17:03 14 respect to that specific limitation, was different than it  
03:17:06 15 was in the '049 patent, right?

03:17:09 16 A. My recollection, there was an amendment where -- we  
03:17:12 17 just talked about it -- where the word "arbitrary" was  
03:17:15 18 replaced by circular or linear or other, yes, that was --  
03:17:20 19 that was a change in the -- in the claim.

03:17:47 20 THE COURT: Counsel, I've been on the bench two  
03:17:49 21 hours and 25 minutes. We're going to take a short recess.  
03:17:54 22 And while we're on recess, I'd like to see Mr. Fabricant,  
03:17:59 23 Mr. Lambrianakos, Ms. Doan, and Mr. Re in chambers briefly.

03:18:04 24 We stand in recess.

03:18:11 25 COURT SECURITY OFFICER: All rise.

03:28:47 1 (Recess.)

03:28:56 2 COURT SECURITY OFFICER: All rise.

03:28:57 3 THE COURT: Be seated, please.

03:28:59 4 All right. Mr. Lambrianakos, please continue.

03:29:08 5 Q. (By Mr. Lambrianakos) Mr. Godici, we saw that in the  
03:29:11 6 reissue of the '756 into the '059 [sic] there was an  
03:29:19 7 amendment to the delay step, correct?

03:29:21 8 A. I'd have to -- I'd have to look at that. We can tell  
03:29:26 9 that very easily by looking at the claim of the '049  
03:29:31 10 indicating what's in brackets and what's in italics.

03:29:35 11 MR. LAMBRIANAKOS: PTX-1, please, Claim 1. Zoom  
03:29:40 12 in on the delay step quickly, please.

03:29:44 13 Q. (By Mr. Lambrianakos) So do you see at Line 55  
03:30:09 14 "arbitrary numbers"?

03:30:12 15 A. Yes, I see that.

03:30:13 16 Q. And "arbitrary configurations," those were removed from  
03:30:19 17 the claims?

03:30:19 18 A. I see arbitrary numbers are removed from the claims.  
03:30:23 19 Arbitrary -- the word "arbitrary" was removed, not  
03:30:26 20 configurations. It looks like configuration is still in  
03:30:29 21 there.

03:30:30 22 Q. Right, sure. So instead of a plurality of arbitrary  
03:30:33 23 configurations, the claim now says: A plurality of  
03:30:37 24 configurations. So "arbitrary" is removed, right?

03:30:39 25 A. Correct.

03:30:40 1 Q. Now, by removing "arbitrary," is it your view the  
03:30:47 2 claims have been broadened or narrowed?

03:30:51 3 A. Well, I'll just go by what the -- what the attorney  
03:30:55 4 told the Patent Office. He said, we're clarifying, okay.  
03:30:59 5 So when he said that the claims of the application were  
03:31:05 6 amended and pointed out those amendments, he said this is  
03:31:08 7 for clarification purposes. Again, I'm not here to -- to  
03:31:13 8 opine on the interpreting the claim or the scope of the  
03:31:17 9 claim.

03:31:18 10 Q. You think --

03:31:19 11 A. But the attorney told us that it's for clarification  
03:31:21 12 purposes.

03:31:21 13 Q. You think that checking the box that the claim is  
03:31:24 14 broadened or narrowed was false?

03:31:27 15 A. You mean in the original two declarations? Is that  
03:31:36 16 what you're asking?

03:31:37 17 Q. In the amendment to the -- in the '049 reissue --

03:31:43 18 A. Correct.

03:31:43 19 Q. -- would you view the checking of the box as broadening  
03:31:48 20 to have been false based on this amendment?

03:31:50 21 A. I guess I -- I'm not quite understanding your question,  
03:31:58 22 other than the way I've already answered it. What the  
03:32:00 23 applicant told the Patent Office with respect to this  
03:32:04 24 amendment, that it was made for clarity purposes, and --  
03:32:09 25 and when -- when asked to identify or when required to

03:32:12 1 identify if there's a broadened claim, this claim wasn't  
03:32:19 2 identified as a broadened claim. It was -- the changes  
03:32:23 3 were identified as clarification changes.

03:32:27 4 Q. In your view, if this claim were indefinite because of  
03:32:30 5 the use of the word "arbitrary," would this amendment be  
03:32:31 6 broadening?

03:32:31 7 A. Again, you're asking me to interpret the scope of the  
03:32:36 8 claim. What -- what the applicant said was that the  
03:32:41 9 original claim was vague. That was the wording that --  
03:32:45 10 that the applicant put in the declaration and that this  
03:32:50 11 amendment clarified that claim.

03:32:51 12 I can only tell you what the applicants told the  
03:32:54 13 Patent Office.

03:32:55 14 Q. So you -- you can't tell what the applicant was  
03:32:57 15 thinking regarding his intent when he checked the boxes,  
03:33:02 16 right?

03:33:02 17 A. I'm not here to speculate on what the applicant was  
03:33:05 18 thinking. I'm here to tell you what the record shows.

03:33:09 19 Q. And all you know from the record is that a box --  
03:33:14 20 certain boxes were checked and others weren't, and it  
03:33:18 21 changed over time, right?

03:33:19 22 A. No, that's not correct. I think it's -- it's much more  
03:33:23 23 serious than that. There's a -- there's a requirement that  
03:33:26 24 if you're broadening the claim, you must identify the claim  
03:33:31 25 that's broadened, and that's a requirement. And you must

03:33:33 1 tell the Patent Office how it was broadened.

03:33:36 2 And after being rejected -- the claims being  
03:33:39 3 rejected for not identifying that information, the  
03:33:46 4 applicant decided to change the declaration, not check that  
03:33:48 5 particular block, and state that the clarifications were  
03:33:50 6 for clarity purposes.

03:33:55 7 So it changed the purpose -- the way I see it from  
03:33:58 8 the Patent Office's perspective -- it changed the purpose  
03:34:00 9 of the reexamination from broadening to clarifying.

03:34:02 10 Q. If the -- if the attorney was correct in unchecking the  
03:34:09 11 box, then there's no inequitable conduct, right?

03:34:17 12 A. If the attorney was correct, but there was a broadened  
03:34:21 13 claim -- the attorney testified in his deposition that  
03:34:26 14 Claim 32 was broadened. So it was an improper declaration  
03:34:29 15 because it failed to identify the fact that there was a  
03:34:32 16 broadened claim.

03:34:34 17 Q. Now, it's important to identify whether your reissue is  
03:34:42 18 broadening based on a two-year limit, correct?

03:34:45 19 A. Correct. We haven't discussed that. But you are  
03:34:47 20 required to -- if you want a broadening reissue, you have  
03:34:52 21 to file your case within two years of the issuance of the  
03:34:55 22 underlying patent.

03:34:56 23 Q. And both of the -- and the reissue -- the '049 reissue  
03:35:00 24 was filed within two years, correct?

03:35:02 25 A. It was filed on the date -- the exact two-year date,

03:35:06 1 yes.

03:35:06 2 Q. So the applicant had the right to seek a broadening  
03:35:10 3 reissue at that time?

03:35:10 4 A. Had the right to, yes. But we see what happened.

03:35:24 5 MR. LAMBRIANAKOS: Nothing further, Your Honor.

03:35:27 6 THE COURT: All right.

03:35:27 7 MS. DOAN: Brief redirect, Your Honor? Very  
03:35:29 8 brief?

03:35:30 9 THE COURT: Ms. Doan?

03:35:31 10 MS. DOAN: Yes, Your Honor.

03:35:31 11 THE COURT: Do you have something that has not  
03:35:33 12 been raised before that I have not heard before that is for  
03:35:36 13 the first time only? If you do, I'll allow you to --

03:35:40 14 MS. DOAN: I think so, Your Honor. I don't know.

03:35:44 15 THE COURT: Well, if you don't know, I don't know  
03:35:46 16 who does.

03:35:47 17 MS. DOAN: Okay. I'll be very brief.

03:35:49 18 THE COURT: Take a minute.

03:35:50 19 MS. DOAN: Yes, Your Honor.

03:35:50 20 REDIRECT EXAMINATION

03:35:52 21 BY MS. DOAN:

03:35:52 22 Q. Mr. Godici, was the Li article or the Brandstein book  
03:35:56 23 considered by the Patent Office in -- in the applications  
03:36:02 24 for the '756 and '049 patents?

03:36:02 25 A. No, there's no indication that the patent examiner

03:36:06 1 considered either of those two references.

03:36:07 2 Q. Were they ever listed on an IDS or the actual reference  
03:36:11 3 provided to the Patent Office?

03:36:13 4 A. No.

03:36:13 5 Q. Is it still the rule that non-patent literature has to  
03:36:16 6 be provided by the applicant?

03:36:18 7 A. Any information that's material to examination,  
03:36:22 8 including non-patent literature, has to be submitted to the  
03:36:26 9 Patent Office.

03:36:26 10 Q. Mr. Lambrianakos was asking you about the false  
03:36:29 11 declarations that you were talking about earlier.

03:36:29 12 A. Yes.

03:36:30 13 Q. With respect to your opinion on the false declaration,  
03:36:32 14 were you focusing on the third declaration being the false  
03:36:36 15 declaration?

03:36:36 16 A. Yes.

03:36:37 17 Q. So any comments that Mr. Lambrianakos made about the  
03:36:37 18 first declaration would be irrelevant to your declar --  
03:36:43 19 your opinion about the false declaration on the third  
03:36:46 20 declaration, correct?

03:36:46 21 A. That's correct.

03:36:46 22 Q. Is there anything he asked about that changed your  
03:36:50 23 opinions that you gave to Judge Gilstrap earlier?

03:36:52 24 A. No, there isn't.

03:36:54 25 MS. DOAN: Thank you, sir.



03:36:55 1 THE COURT: Mr. Lambrianakos, do you have anything  
03:36:57 2 else for this witness?

03:36:58 3 MR. LAMBRIANAKOS: No, Your Honor.

03:36:59 4 THE COURT: All right. Thank you.

03:37:00 5 Counsel, I assume this is the totality of the  
03:37:07 6 evidence that you intend to present.

03:37:08 7 MS. DOAN: It is, Your Honor. We do have our two  
03:37:11 8 exhibits that we'd like to submit -- the deposition --  
03:37:13 9 excerpts from the deposition testimony of Ashok Tankha and  
03:37:17 10 Dr. Manli Zhu as DTX-1026.

03:37:19 11 THE COURT: All right. If you'd approach and hand  
03:37:22 12 those to the courtroom deputy.

03:37:23 13 Are there counter-designations from the Plaintiff?

03:37:27 14 MR. LAMBRIANAKOS: No, Your Honor.

03:37:27 15 THE COURT: All right. All right. I'm now going  
03:37:33 16 to afford each side -- you may step down.

03:37:36 17 THE WITNESS: Thank you.

03:37:38 18 THE COURT: Thank you, sir.

03:37:38 19 I'm now going to afford each side seven and a half  
03:37:42 20 minutes for a targeted closing statement regarding the  
03:37:46 21 evidence that's been presented.

03:37:47 22 Let me hear first from the moving Defendant,  
03:37:50 23 Amazon.

03:37:51 24 MR. RE: Thank you, Your Honor.

03:37:54 25 And thank you for allowing us to do this at this

03:38:00 1 very delicate hour.

03:38:01 2 I do want to clarify a few things. And having  
03:38:06 3 practiced patent law for 35 years, I see some  
03:38:09 4 miscommunication that's occurring.

03:38:10 5 First, I want to address your real estate analogy.  
03:38:13 6 This is not like real estate at all. The public import of  
03:38:17 7 being honest with the Patent Office rises to a much higher  
03:38:21 8 level, as we saw, including imprisonment up to five years.

03:38:25 9 THE COURT: As I -- as I recall, that was a  
03:38:26 10 question to the witness. You're not attempting to offer  
03:38:28 11 testimony, are you, Mr. Re?

03:38:30 12 MR. RE: No, but I -- I think it's important.

03:38:33 13 THE COURT: You're telling me what does and  
03:38:35 14 doesn't happen at the Patent Office? That's not an attempt  
03:38:37 15 to give me testimony?

03:38:38 16 MR. RE: No, I gave you argument on the duty to  
03:38:41 17 disclose.

03:38:42 18 THE COURT: All right. Go ahead.

03:38:42 19 MR. RE: The duty to disclose, very, very serious.  
03:38:46 20 For example, the reissue that we ended with, the third  
03:38:50 21 ground, to remove -- to remove that box -- to affirmatively  
03:38:56 22 remove a checkmark when you are, in fact, broadening is a  
03:39:01 23 serious violation.

03:39:02 24 The checkmark is what tells the Patent Office, if  
03:39:08 25 it's broadened, they must do additional searching. The

03:39:11 1 claim is broadened. It's like starting over. You can only  
03:39:15 2 seek a broadening reissue in the two years after issuance.

03:39:15 3 And after getting the rejection twice for an  
03:39:22 4 improper declaration, the attorney removes the checkmark  
03:39:24 5 and does, in fact, broaden the claims. And it's undisputed  
03:39:29 6 the claims were broadened.

03:39:31 7 What Mr. Lambrianakos was focusing on was Claim 1,  
03:39:34 8 where the arbitrary and configuration language was changed.

03:39:38 9 But what he did not address was that the other  
03:39:41 10 claims were broadened. And, particularly, it stands  
03:39:45 11 undisputed on this record that at least Claim 32 was  
03:39:48 12 broadened. That is dispositive of the fact that the  
03:39:53 13 checkmark is absolutely incorrect, and we have the attorney  
03:39:56 14 admitting that he did, in fact, broaden and remove the  
03:39:59 15 checkmark from the reissue.

03:40:00 16 This reissue oath has nothing whatsoever to do  
03:40:04 17 with the reissue oath we were discussing on the second  
03:40:06 18 reissue. This is the first reissue.

03:40:10 19 And there -- it appears they're abusing the  
03:40:13 20 reissue process. And, obviously, they're using it to  
03:40:16 21 disclose additional references for future patents. That's  
03:40:21 22 what's going on here.

03:40:21 23 I now want to discuss Brandstein. The applicant  
03:40:25 24 has the duty to provide Brandstein. There's no question  
03:40:29 25 the applicant knows about Brandstein, used Brandstein,

03:40:32 1 cited Brandstein in an article.

03:40:35 2 So, rarely, do you have a case where it is  
03:40:37 3 undisputed that the applicant knew about Brandstein, knew  
03:40:40 4 about its content, used it to file applications.

03:40:44 5 And the argument we heard today is that somehow it  
03:40:47 6 was disclosed to the Patent Office because it was cited in  
03:40:51 7 the provisional.

03:40:53 8 I've never heard such an argument. And I'll tell  
03:40:57 9 you a few reasons why that argument is so serious.

03:41:00 10 Number one, the applicant is not relieved of any  
03:41:03 11 duty by virtue of the provisional.

03:41:06 12 Number two, the provisional is a provisional. It  
03:41:09 13 is merely a placeholder for the priority date. It is never  
03:41:15 14 examined. It has nothing whatsoever to do with the  
03:41:17 15 examination process.

03:41:18 16 Number three, to ask a non-lawyer about whether  
03:41:21 17 it's incorporated by reference was really out of bounds.  
03:41:24 18 It's not incorporated by reference. The related  
03:41:27 19 applications are simply mentioned to show priority. It's  
03:41:31 20 just the priority date -- just the priority date.

03:41:35 21 And you may -- in the old days before we had a  
03:41:39 22 provisional system, inventors used to mail the invention to  
03:41:43 23 themselves. They did that in order to have a postmark from  
03:41:46 24 the pat -- from the U.S. Postal Service to prove when they  
03:41:48 25 had possession of the invention.

03:41:51 1 The Patent Office eliminated the need to do that  
03:41:53 2 by a provisional system. The provisional application is  
03:41:57 3 kept in the archives of the Patent Office and is not looked  
03:42:00 4 at. And it was not looked at here, because none of the  
03:42:03 5 prior art was in the one-year window.

03:42:07 6 Since all the prior art was more than a year prior  
03:42:09 7 to the provisional, there was no reason to examine the  
03:42:16 8 provisional to see if that provisional date had any  
03:42:19 9 meaning. The 2000 date meaning is irrelevant in this case,  
03:42:23 10 irrelevant in the jury trial, and irrelevant on inequitable  
03:42:28 11 conduct.

03:42:28 12 And it was not -- the 2010 date was never at issue  
03:42:31 13 because all of the prior art was 102(b) statutory prior  
03:42:34 14 art. It's prior art regardless of the date of invention.  
03:42:38 15 And, therefore, the -- the provisional was of no relevance  
03:42:40 16 whatsoever in this examination.

03:42:44 17 And they cannot rely on that provisional for any  
03:42:47 18 purpose in this trial, jury or otherwise.

03:42:50 19 Next, there was no opinion by Mr. Godici on  
03:42:57 20 materiality. The materiality of these references is  
03:42:59 21 undisputed. Mr. Godici was not a technical expert. He was  
03:43:04 22 a patent procedure expert, having lived his entire adult  
03:43:10 23 life in the Patent Office. He does not know anything about  
03:43:12 24 microphone arrays, but that wasn't relevant here. We  
03:43:14 25 didn't need him to talk about the technology.

03:43:17 1 All of the experts, including Dr. Zhu, admitted  
03:43:22 2 that the entirety of Limitation [C] was disclosed in the Li  
03:43:27 3 article, for example. It's all disclosed in the  
03:43:31 4 references. That's not even the debate.

03:43:33 5 And Limitation [C] was a reason for allowance for  
03:43:39 6 the '756, and without the '756, you can't have any  
03:43:42 7 reissues. And that's infectious enforceability. You  
03:43:46 8 cannot cure inequitable conduct. You cannot cure it by  
03:43:49 9 reissue. No matter how much you start to disclose, it's  
03:43:53 10 too late. And the only way to cure inequitable conduct is  
03:43:56 11 to tell the Patent Office what you did wrong.

03:43:58 12 Which leads me back to the importance of the  
03:44:01 13 nature of the error. Error must be explained to get any  
03:44:04 14 reissue.

03:44:05 15 Lastly, the Li article. Again, no doubt the  
03:44:09 16 applicant knows about his own article. No doubt he knows  
03:44:12 17 about Brandstein. He cites Brandstein in his own Li  
03:44:15 18 article. Li article was obviously material prior art,  
03:44:18 19 regardless of the shape of the array.

03:44:21 20 Mr. Lambrianakos, in my view, very misleading  
03:44:24 21 cross-examination to talk about a reference -- a limitation  
03:44:27 22 not even part of the reasons for allowance. Who cares if  
03:44:31 23 it's a polka dot array? Who cares the nature of the array?  
03:44:36 24 Who cares whether it has sound source localization? Who  
03:44:40 25 cares whether they're all in the same exact DSP?

03:44:42 1 The point is, if the examiner had any of these  
03:44:45 2 references, this patent would not have issued, period.

03:44:50 3 THE COURT: You have one minute remaining.

03:44:51 4 MR. RE: And that's the main point. The patent  
03:44:54 5 wouldn't have been allowed. The applicant knew about it.  
03:44:57 6 The applicant is a very sophisticated applicant. The  
03:45:00 7 applicants had several patent lawyers. He fired a patent  
03:45:04 8 lawyer for not keeping him abreast of what's going on.

03:45:08 9 The privilege log showed he received each and  
03:45:11 10 every amendment, each and every argument. He participated  
03:45:14 11 in the prosecution.

03:45:15 12 His language is very good. He's very  
03:45:19 13 knowledgeable, has dozens of patent applications, many  
03:45:24 14 filed many, many years earlier than the dates we're talking  
03:45:26 15 about here.

03:45:27 16 He knows about the publication system. He knows  
03:45:30 17 about prior art. He knows about the different kinds of  
03:45:33 18 patents. And he had Kenyon & Kenyon, one of the most  
03:45:37 19 sophisticated patent firms in the country at the time.  
03:45:40 20 They no longer exist. But he's very knowledgeable, and  
03:45:44 21 dealt with his patent lawyer all the time.

03:45:46 22 And we cut a deal in this case to exchange any  
03:45:51 23 transmittals of prior art being exchanged between the --  
03:45:51 24 the lawyer and Dr. Li --

03:45:52 25 THE COURT: Mr. Re, your time is up. Take one or

03:45:55 1 two more sentences and finish for me.

03:45:58 2 MR. RE: And it shows he never gave Brandstein to  
03:46:01 3 his lawyer, and he only gave Li, and Li was still not  
03:46:06 4 disclosed. Pretty good evidence. I think it's plenty  
03:46:14 5 reasonable to infer intent by Dr. Li, but particularly by  
03:46:20 6 Mr. Tankha.

03:46:20 7 Thank you, Your Honor.

03:46:21 8 THE COURT: Thank you.

03:46:21 9 Let me hear closing argument from Plaintiff.

03:46:23 10 MR. LAMBRIANAKOS: Thank you, Your Honor.

03:46:31 11 So there are three specific issues here.

03:46:34 12 Issue one is Brandstein. Defendant thinks that  
03:46:38 13 the failure to disclose Brandstein within the body of the  
03:46:41 14 non-provisional specification and removing it supposedly  
03:46:45 15 from that specification is significant.

03:46:48 16 However, Defendants have no response to the fact  
03:46:50 17 that the provisional was incorporated by reference, its  
03:46:54 18 contents were incorporated by reference, and to the extent  
03:46:57 19 that identifying Brandstein in the body of the  
03:46:59 20 non-provisional would have been sufficient, it was by  
03:47:02 21 operation of law disclosed in the non-provisional through  
03:47:06 22 the incorporation by reference. It's there from the very  
03:47:10 23 beginning of the '756 patent application. It was there all  
03:47:13 24 the way through.

03:47:14 25 Now, they showed some testimony from Dr. Stern,



03:47:17 1 who said that all the limitations were disclosed there.  
03:47:20 2 But we know on cross-examination, he admitted that a  
03:47:23 3 digital signal processor that had all three of the  
03:47:26 4 operative units in it was not specifically disclosed.

03:47:30 5 And even the evidence they showed merely said that  
03:47:34 6 DSPs can have algorithms on them, did not disclose the  
03:47:37 7 three units.

03:47:38 8 And those three units are in the '756 patent. The  
03:47:42 9 '756 patent claims include all three of those units.

03:47:44 10 And we know that the Li article did not disclose  
03:47:48 11 adaptive beamforming, which was an important element of the  
03:47:50 12 claims. It did not disclose sound source localization. It  
03:47:53 13 did not disclose a plurality of arbitrary configurations  
03:47:58 14 that are part of the -- of the claim.

03:48:05 15 And, importantly, the delay step provides  
03:48:10 16 information that enables beamforming for a plurality of  
03:48:11 17 arbitrary configurations in the '756 application so -- '756  
03:48:14 18 patent. So it's in the delay step. That delay step has  
03:48:18 19 different scope than the scope of what's disclosed in the  
03:48:21 20 Li article, which discloses only one configuration, which  
03:48:24 21 is linear.

03:48:25 22 Now, is a linear configuration arbitrary? Well,  
03:48:30 23 the problem with arbitrary was that no one really knows  
03:48:34 24 what it means. That -- that claim -- that patent was  
03:48:37 25 reissued in part because the arbitrary configuration

03:48:41 1 limitation is probably indefinite.

03:48:44 2           And so when you amend the claim to remove  
03:48:48 3 indefiniteness, is that broadening because you went from no  
03:48:52 4 scope to broader scope? Is it narrowing because you went  
03:48:57 5 from a potentially infinite scope to a narrower scope? I'm  
03:49:01 6 not sure. And I'm not sure the patent -- the patent lawyer  
03:49:03 7 knew either.

03:49:04 8           And so when we have that amendment, we have this  
03:49:08 9 significant question about what the effect of that  
03:49:09 10 amendment was. Was it broadening? Was it narrowing? It's  
03:49:13 11 unclear.

03:49:14 12           Now, with respect to intent, I don't think we've  
03:49:19 13 heard anything here that would give -- that would support  
03:49:23 14 clear and convincing evidence that anyone intended to  
03:49:27 15 deceive the Patent Office by not disclosing material prior  
03:49:32 16 art.

03:49:32 17           I would argue that the Li article was not  
03:49:35 18 material. It was so immaterial to the '049 patent,  
03:49:40 19 Your Honor, that in Tuesday's invalidity presentation by  
03:49:44 20 the Defendant, the Defendant dropped its arguments based on  
03:49:49 21 Li as a primary reference. They had elected Li with  
03:49:52 22 Brandstein, I believe, as a combination that they elected  
03:49:56 23 to trial.

03:49:57 24           They came to the Court, and they never asserted  
03:50:00 25 that. They brought up Li just with respect to the delay

03:50:06 1 limitation, probably in preparation for today, but  
03:50:11 2 otherwise they dropped that argument even though they had  
03:50:13 3 an hour left of trial time.

03:50:16 4 And so my view is, if that reference was so  
03:50:19 5 material to patentability that it would at least be a  
03:50:21 6 significant primary reference to the '049 patent, that  
03:50:24 7 would have been asserted at trial. There was plenty of  
03:50:28 8 time to do it.

03:50:28 9 And the difference between, of course, the two  
03:50:30 10 patent claims are the specific DSP limitation. But also  
03:50:33 11 the -- the difference between the '756 and the -- and the  
03:50:39 12 '049 goes to this plurality of configurations limitation,  
03:50:42 13 as well.

03:50:43 14 And so it's very, very significant that the  
03:50:45 15 Defendant did not regard the Li reference as material  
03:50:48 16 enough to spend five or 10 more minutes at trial to go over  
03:50:52 17 that and make an invalidity argument to Your Honor.

03:50:54 18 So looking at all the factors, looking at the  
03:50:59 19 ambiguity involved and the amendments that gave rise to the  
03:51:05 20 '049 with regard to the limitations which were changed,  
03:51:07 21 which were amended, we don't see any basis to conclude by  
03:51:11 22 clear and convincing evidence that the change in the check  
03:51:13 23 box was intentionally done with a specific intent to  
03:51:17 24 deceive the Patent Office.

03:51:18 25 We don't see the Brandstein issue as rising to

03:51:21 1 that level of intent because it was incorporated by  
03:51:25 2 reference. And there's -- there's really no question that  
03:51:28 3 that document, the entirety of the provisional, is  
03:51:31 4 incorporated by reference, including the reference to  
03:51:34 5 Brandstein. And, of course, we know that Li was just a  
03:51:37 6 linear array, had no sound source localization, had a  
03:51:39 7 different delay disclosure than '756.

03:51:43 8 THE COURT: You have two minutes,  
03:51:45 9 Mr. Lambrianakos.

03:51:45 10 MR. LAMBRIANAKOS: And so, based on all those  
03:51:47 11 facts, Your Honor, we don't believe that the Defendants  
03:51:50 12 have even approached the level of proof required to show  
03:51:53 13 material -- materiality and the specific intent to deceive  
03:51:58 14 the Patent Office by clear and convincing evidence.

03:51:59 15 Thank you, Your Honor.

03:52:01 16 THE COURT: Thank you.

03:52:02 17 Thank you, counsel, for your able argument and the  
03:52:07 18 presentation of evidence to the bench regarding this  
03:52:11 19 inequitable conduct defense as urged by Defendants.

03:52:15 20 These matters -- this matter is under submission.

03:52:20 21 MS. DOAN: Your Honor?

03:52:21 22 THE COURT: And I appreciate the presentation you  
03:52:23 23 made today.

03:52:23 24 Do you have a question, Ms. Doan?

03:52:25 25 MS. DOAN: I do, Your Honor. How would you like

03:52:27 1 us to submit the exhibits that came into evidence today? I  
03:52:31 2 don't know we've had a chance to meet --

03:52:33 3 THE COURT: I'd like you to deliver them to the  
03:52:37 4 courtroom deputy, who will see that I get them.

03:52:39 5 Mr. Fabricant?

03:52:41 6 MR. FABRICANT: Would Your Honor like any  
03:52:43 7 post-trial submissions on this trial?

03:52:45 8 THE COURT: I'll leave that option open. I won't  
03:52:50 9 order it at this time. Once I review my notes and the  
03:52:55 10 evidence that you've submitted in tangible form, I may ask  
03:52:56 11 for additional post-trial briefing. I may not. I'll carry  
03:53:00 12 that option as a part of my consideration of what you  
03:53:04 13 presented today.

03:53:04 14 MR. FABRICANT: Thank you, Your Honor.

03:53:04 15 (Bench trial concluded.)

03:53:06 16 (Jury trial.)

03:53:06 17 THE COURT: All right. Counsel, we still do not  
03:53:08 18 have a verdict from the jury. They are clearly still  
03:53:10 19 deliberating. It's about six or seven minutes until 4:00  
03:53:13 20 p.m. You're welcome to remain here and wait for a verdict  
03:53:18 21 with the Court. Or if you're offsite, have your cell  
03:53:24 22 phones on, and be prompt when we call you to return.

03:53:27 23 Other than that, we stand in recess.

03:53:29 24 COURT SECURITY OFFICER: All rise.

03:53:30 25 (Recess.)

04:00:32 1 (Jury out.)

04:00:34 2 (Jury trial.)

04:00:34 3 COURT SECURITY OFFICER: All rise.

04:00:36 4 THE COURT: Be seated, please. Counsel, I've  
04:00:42 5 received the following note from the jury delivered by the  
04:00:45 6 Court Security Officer.

04:00:46 7 And it says: We have reached a unanimous  
04:00:50 8 decision. Thanks. Elizabeth Edwards.

04:00:54 9 I'll mark this as Item 3 for identification, and  
04:00:57 10 I'll hand the original to the courtroom deputy.

04:00:59 11 Let me ask, is either Plaintiff or Defendant aware  
04:01:12 12 of anything the Court should take up before I bring in the  
04:01:15 13 jury and receive the verdict?

04:01:17 14 MS. TRUELOVE: Nothing from Plaintiff, Your Honor.

04:01:19 15 MR. DACUS: Nothing from Amazon, Your Honor.

04:01:20 16 THE COURT: I probably don't need to say this, but  
04:01:22 17 I will out of an abundance of caution.

04:01:25 18 No matter what the verdict is, I don't expect any  
04:01:28 19 reactions from anyone in the courtroom. I think you all  
04:01:31 20 know and understand that.

04:01:32 21 All right. Let's bring in the jury, please,  
04:01:34 22 Mr. Nixon.

04:01:35 23 COURT SECURITY OFFICER: All rise.

04:02:20 24 (Jury in.)

04:02:21 25 THE COURT: Please be seated.

04:02:22 1 Ms. Edwards, I understand you're the foreperson of  
04:02:27 2 the jury?

04:02:27 3 THE FOREPERSON: Yes, sir.

04:02:28 4 THE COURT: Has the jury reached a unanimous  
04:02:30 5 verdict?

04:02:32 6 THE FOREPERSON: Yes, sir.

04:02:33 7 THE COURT: Would you hand the signed and dated  
04:02:39 8 verdict form to the Court Security Officer who will bring  
04:02:46 9 it to me?

04:02:55 10 Ladies and gentlemen of the jury, I'm going to  
04:03:22 11 announce the verdict into the record at this time. And I'd  
04:03:26 12 like each member of the jury to listen very carefully as I  
04:03:30 13 do. Because after I have announced the verdict into the  
04:03:34 14 record, I'm going to poll the jury and ask each of you if  
04:03:37 15 this is, in fact, your verdict so we can confirm on the  
04:03:40 16 record that it is the unanimous verdict of all eight  
04:03:43 17 members of the jury.

04:03:43 18 Turning to the verdict form. The first question  
04:03:54 19 is located on Page 4.

04:03:56 20 Question No. 1: Did Vocalife prove by a  
04:04:00 21 preponderance of the evidence that Amazon infringed any of  
04:04:03 22 the asserted claims?

04:04:04 23 The jury's answer is: Yes.

04:04:07 24 Turning to Question No. 2 on the verdict form.

04:04:17 25 Did Amazon prove by clear and convincing evidence

04:04:18 1 that any of the following asserted claims are invalid?

04:04:22 2 Claim 1 of the '049 patent, the jury's answer  
04:04:28 3 is: No.

04:04:29 4 Claim 8 of the '049 patent, the jury's answer  
04:04:34 5 is: No.

04:04:34 6 Question 3: Did Vocalife prove by a preponderance  
04:04:41 7 of the evidence that Amazon willfully infringed any of the  
04:04:43 8 asserted claims that you found were infringed?

04:04:48 9 The jury's answer is: No.

04:04:51 10 Question 4B of the verdict form: What sum of  
04:04:58 11 money, if any, paid now in cash has Vocalife proven by a  
04:05:03 12 preponderance of the evidence would compensate Vocalife for  
04:05:07 13 its damages resulting from infringement?

04:05:10 14 The jury's answer: \$5 million.

04:05:14 15 Question 4B: Is the amount you awarded in  
04:05:25 16 Question 4A a lump sum representing damages for past and  
04:05:30 17 future sales, or is the amount you awarded in Question 4A a  
04:05:34 18 reasonable royalty for past sales only?

04:05:35 19 The jury's answer: Is lump sum.

04:05:38 20 Turning to Page 9, the final page of the verdict  
04:05:45 21 form, I find that it is dated with today's date, October  
04:05:49 22 the 8th, 2020. And it's signed by Ms. Elizabeth Edwards,  
04:05:53 23 as foreperson of the jury.

04:05:56 24 Ladies and gentlemen of the jury, I'm now going to  
04:05:59 25 poll you to make sure this is, in fact, the unanimous



04:06:02 1 verdict of the entire eight member -- eight members of our  
04:06:07 2 jury.

04:06:07 3 If this is your verdict as I have read it and  
04:06:10 4 announced it, would you please stand up?

04:06:13 5 (Jury polled.)

04:06:19 6 THE COURT: Thank you. Please be seated.

04:06:21 7 Let the record reflect that all eight members of  
04:06:26 8 the jury immediately stood and rose in response to the  
04:06:30 9 Court's question to poll the jury.

04:06:32 10 Ladies and gentlemen, I find that this is the  
04:06:34 11 unanimous verdict of all eight members of the jury. And  
04:06:36 12 the Court accepts your verdict. And I will deliver the  
04:06:39 13 original signed verdict form to the courtroom deputy.

04:06:42 14 Ladies and gentlemen, this now completes the trial  
04:06:46 15 of this case. From the very beginning of it, I've been  
04:06:50 16 giving you instructions over and over and over again about  
04:06:54 17 not discussing this case or your experience or what you  
04:06:58 18 think about anything that's happened here in court with  
04:07:01 19 anyone.

04:07:02 20 I'm now releasing you from that instruction, and  
04:07:06 21 I'm releasing you from all the instructions I've given you  
04:07:10 22 previously. That means you are perfectly free to talk  
04:07:13 23 about this case with anybody you'd like to. This means you  
04:07:19 24 are also perfectly free not to discuss this case with  
04:07:26 25 anybody of your choosing. The choice is yours, 100 percent

04:07:28 1 yours.

04:07:29 2 Let me explain something to you. In this court  
04:07:33 3 for as long as I can remember, and I've practiced law here  
04:07:35 4 30 years before I got this job, it has always been the  
04:07:38 5 established practice that the lawyers who very much would  
04:07:42 6 like to know what you thought about the job they did are  
04:07:45 7 not entitled to initiate a conversation with any of you  
04:07:50 8 about this case.

04:07:52 9 But the way that has traditionally worked is the  
04:07:56 10 lawyers will beat you out of the courthouse, and they will  
04:08:00 11 be at the bottom of the front steps when you go out of the  
04:08:03 12 building, and you will have to walk right by them.

04:08:06 13 And they will be there smiling at you hoping that  
04:08:08 14 you will stop and have a conversation with them. If you  
04:08:10 15 want to do that, you're perfectly free to do that. If you  
04:08:13 16 don't want to do that, I promise you, they will not stop  
04:08:18 17 you, and they will not initiate a conversation with you.  
04:08:20 18 And if you don't want to discuss anything about the case  
04:08:23 19 with them, just smile and walk right past them.

04:08:26 20 Also, lately, I have expanded this practice a  
04:08:33 21 little bit to make it easier on everybody involved.

04:08:37 22 In a minute, I'm going to give you a couple of  
04:08:39 23 phone numbers for Ms. Truelove on the Plaintiff's side of  
04:08:45 24 the case and Mr. Dacus on the Defendants' side of the case.  
04:08:48 25 And these are cell phones that will ring in their pocket or

04:08:52 1 on their desk or in their purse, wherever they keep them.

04:08:57 2 If at any time you'd like to talk with either or  
04:08:59 3 both of them about your experience, pick up the phone and  
04:09:02 4 call them. I promise you they will take your call and be  
04:09:06 5 anxious to hear what you have to say.

04:09:09 6 If you don't have any interest or desire to talk  
04:09:11 7 with them about the case or answer the questions they might  
04:09:14 8 have, don't call them. They will not call you. It is  
04:09:17 9 strictly your decision and your decision alone.

04:09:19 10 But I found by giving you their cell phone numbers  
04:09:23 11 they don't feel so compelled to line up like toy soldiers  
04:09:28 12 at the bottom of the front steps so that you have to walk  
04:09:30 13 right by them.

04:09:32 14 They're hopeful that you will call them tomorrow  
04:09:34 15 or next week or some time that's convenient for you.  
04:09:40 16 Again, that is your decision, your decision completely.

04:09:42 17 Also, ladies and gentlemen, I want to tell you how  
04:09:45 18 much the Court appreciates your service in this case. This  
04:09:49 19 has been a long trial. It's been a difficult trial. We  
04:09:53 20 have started early, and we have gone late.

04:09:57 21 And each of you have been exemplary jurors. You  
04:10:00 22 have listened carefully. You have taken copious notes.  
04:10:05 23 You have paid attention. I have watched you. That is part  
04:10:08 24 of my job. That's part of why you have those plastic face  
04:10:12 25 shields instead of masks so I can see your faces, and I've

04:10:15 1 looked at you throughout this trial.

04:10:17 2           And I've conducted enough jury trials in my time  
04:10:20 3 on the bench to know when a jury is paying attention and  
04:10:23 4 when they're not. And you have paid rapt attention to  
04:10:27 5 everything throughout this trial. You've done everything  
04:10:29 6 the Court has asked you to do. You've been on time, you  
04:10:32 7 haven't complained, and you've served with distinction, as  
04:10:36 8 members of this jury.

04:10:37 9           And I want to tell you on behalf of the Court, the  
04:10:40 10 Court staff, and both of these parties and their lawyers,  
04:10:44 11 and everybody present in this courtroom, we all recognize  
04:10:48 12 and appreciate and honor your service as jurors, because we  
04:10:53 13 all know that without you, we would not be able to have the  
04:10:58 14 kind of trial we just had. You are absolutely essential to  
04:11:02 15 the process.

04:11:03 16           And we know that every one of you had other things  
04:11:06 17 to do over the last several days that were important in  
04:11:10 18 your lives, and you put that on hold. You made a real and  
04:11:14 19 material sacrifice to serve your country as jurors in this  
04:11:17 20 case. And that's no small thing. You have each rendered  
04:11:22 21 very real and important public service. And I believe  
04:11:26 22 that's worth special recognition.

04:11:30 23           Now, before we were visited by the Coronavirus, my  
04:11:40 24 practice was always to ask the members of the jury at this  
04:11:43 25 same juncture in another trial to go back into the jury

04:11:47 1 room and let me come to the jury room and let me shake each  
04:11:50 2 hand and look each juror in the eye and tell them  
04:11:55 3 personally, thank you.

04:11:56 4           You understand I'm not going to do that today,  
04:11:58 5 given the world in which we currently live. But I do have  
04:12:00 6 a letter of appreciation which I have signed. I do have a  
04:12:05 7 certificate from the Court recognizing your service for  
04:12:10 8 each of you. And I'd like to give you that right now.

04:12:14 9           I'll paperclip these appropriate phone numbers to  
04:12:17 10 it so you'll have those at the same time. And I'd like to  
04:12:20 11 let you take that with you.

04:12:21 12           Mr. Mixon, if you will help me.

04:12:25 13           COURT SECURITY OFFICER: Yes, sir.

04:12:25 14           THE COURT: I have a letter and certification of  
04:12:28 15 appreciation for Ms. Banks. That's Juror No. 1, if you'll  
04:12:32 16 take that to her.

04:12:39 17           Ms. Banks, thank you for your service.

04:12:42 18           This is for Ms. Edwards. Ms. Edwards, thank you  
04:12:50 19 for your service.

04:12:51 20           This is for Ms. Burton. Thank you, Ms. Burton,  
04:13:04 21 for your service.

04:13:05 22           This is for Ms. Friday. Thank you, Ms. Friday,  
04:13:19 23 for your service.

04:13:19 24           This is for Mr. Amick. Mr. Amick, thank you for  
04:13:36 25 your service, sir.

04:13:37 1 This is for Ms. Stansbury. Ms. Stansbury, thank  
04:13:58 2 you for your service. And thank you for not having that  
04:14:02 3 baby in the middle of this jury trial.

04:14:04 4 This is for Ms. Huskey. Thank you, Ms. Huskey,  
04:14:15 5 for your service.

04:14:15 6 And last, but not least, for Mr. Smith.  
04:14:27 7 Mr. Smith, thank you for your service, sir.

04:14:29 8 Let me conclude, ladies and gentlemen, by just  
04:14:37 9 giving you a couple housekeeping instructions that may be  
04:14:40 10 of interest to you.

04:14:41 11 I assume you've all left your juror notebooks in  
04:14:46 12 the jury room. They will immediately be shredded by my  
04:14:49 13 staff. None of what you've written in there will be  
04:14:53 14 retained by anybody.

04:14:54 15 Number two, having served on this jury, your names  
04:14:57 16 will come out of the jury wheel for two years. You will  
04:15:01 17 not be called for jury duty in federal court for the next  
04:15:06 18 two years.

04:15:07 19 I cannot tell you what the State of Texas might  
04:15:09 20 do. But the United States District Court for the Eastern  
04:15:14 21 District of Texas will not call you for jury duty for the  
04:15:16 22 next two years. After that period of time, your name will  
04:15:20 23 go back in the hopper.

04:15:21 24 If you need anything that you've not already been  
04:15:26 25 able to get from Ms. Clendening regarding anything related

04:15:30 1 to your jury service, she is in the clerk's office, and she  
04:15:33 2 will be more than happy to accommodate you as you leave.

04:15:36 3 Let me say one more time how much the Court  
04:15:39 4 appreciates your service, how much the Court recognizes the  
04:15:43 5 importance of the service that you've rendered. And let me  
04:15:47 6 thank you one more time for your hard work as jurors in  
04:15:51 7 this case.

04:15:52 8 You are discharged from your position as jurors.  
04:15:56 9 Ladies and gentlemen, travel to your home safely. The  
04:15:59 10 Court wishes you nothing but the best. And you are excused  
04:16:02 11 to leave at this time.

04:16:03 12 COURT SECURITY OFFICER: All rise.

04:16:04 13 (Jury out.)

04:16:04 14 THE COURT: Counsel, that completes the trial of  
04:16:27 15 this case. You are excused.

04:16:30 16 (Court adjourned.)

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CERTIFICATION

I HEREBY CERTIFY that the foregoing is a true and correct transcript from the stenographic notes of the proceedings in the above-entitled matter to the best of my ability.

/S/ Shelly Holmes  
SHELLY HOLMES, CSR, TCRR  
OFFICIAL REPORTER  
State of Texas No.: 7804  
Expiration Date: 12/31/2020

10/8/2020  
Date